Supreme Court, U.S.
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No. 00-

IN THE
Supreme Court of the United States

ALAN L. POCRASS,

Petitioner,

v.

MAXCONN, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether a court can rely on equivalence in a holding of anticipation under 35 U.S.C. § 102.

2. Whether a court, having explicitly held that the prior art lacks a feature literally required by a claim, can nonetheless hold that the claim is anticipated for any reason, including an evidentiary admission by a party.

LIST OF PARTIES

The parties to the proceedings below were Petitioner, Alan L. Pocrass, co-plaintiff Amphenol Corporation, Respondent Maxconn, Inc. ("Maxconn"), and Nu-Way Electronics, which settled at the district court.

The Respondent before this Court is Maxconn. Amphenol Corporation is also being served as a Respondent.

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The Petitioner, Alan L. Pocrass, respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit, entered February 12, 2001.

OPINIONS AND ORDERS BELOW

The opinion of the Court of Appeals for the Federal Circuit is reported at 2001 U.S. App. LEXIS 2189 (Fed. Cir. Feb. 12, 2001), and is reprinted in the Appendix hereto, beginning at page 1a (hereafter "App. 1a"). The decision of the United States District Court for the Northern District of California is reported at 2000 U.S. Dist. LEXIS 20221 (N.D. Cal. Mar. 7, 2000), and is reprinted in the Appendix hereto, beginning at App. 4a. The ruling of the district court on issues of claim interpretation is reported at 1998 U.S. Dist. LEXIS 22506, 52 U.S.P.Q.2d 1178 (N.D. Cal. Nov. 20, 1998), and is reproduced in the Appendix at App. 55a-80a.

STATEMENT OF JURISDICTION

Jurisdiction in the United States District Court of the Northern District of California was pursuant to the provisions of 28 U.S.C. § 1338(a). The appeal to the United States Court of Appeals for the Federal Circuit was timely taken pursuant to the provisions of 28 U.S.C. §§ 1295, 2107. The jurisdiction of this Court to review the judgment of the Federal Circuit is invoked under 28 U.S.C. § 1254(1). The judgment of the Federal Circuit sought to be reviewed was entered on February 12, 2001.

STATUTE INVOLVED

35 U.S.C. § 102. Conditions for patentability: novelty and loss of rights to patent

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,

STATEMENT OF THE CASE

The dispute in the district court involved alleged infringement of U.S. Patent 4,978,317 ("the '317 patent"), which issued on December 19, 1990. The '317 patent is found in the Lodging to this Petition. Appellant and co-plaintiff Amphenol Corp. brought this action against Defendant-Appellee Maxconn, Inc. ("Maxconn") and co-defendant Nu-Way Electronics ("Nu-Way"). The claim at issue on appeal is directed to a connector having a light emitting source within a housing, with the last subparagraph of the claim reading:

> a plurality of conductor wires, including conductor wires from said light emitting source, extending through one of said housing walls arranged in a predetermined spaced-apart array, adapted for insertion within a corresponding array of spaced holes in a printed circuit board.

The specification of the '317 patent discloses and illustrates a single embodiment, in which light emitting sources are contained within the housing and wires from those light emitting sources extend within the housing until they exit through a housing wall. The accused device offered for sale by Maxconn literally satisfied every limitation of the claim, except that instead of having the wires from the light emitting source extend continuously in one piece from the light emitting source to the outside of the housing, the wires in the accused device extended from the light emitting source for a short distance and were soldered to other wires which then extended out of the housing.

A claim construction ("Markman") hearing was held on September 24, 1998, and on November 20, 1998 the district court issued an order construing the claims of the '317 patent (App. 55a-80a). In this Order, the district court agreed with the claim construction advanced by Respondent Maxconn, and held that the claim as properly construed required a single continuous wire extending from the light emitting source to the outside of the housing (a "one-piece wire" construction):

> The Court agrees with Maxconn that the claim language itself suggests that a single strand of conductive material extends from the LED itself out through an opening in the housing wall. While it is common knowledge that the term "wire" includes materials that are in actuality composed of more than one piece of conductive filament laid more or less end to end (e.g., telephone wires, cable wires, and electrical wires), this particular claim relates to a very short segment of wire, not one stretching over feet, yards, or miles. While two pieces of wire joined end-to-end may serve

> the precise functional equivalent of a single wire, the ordinary meaning of the claim is that one continuous piece of wire extends from the LED out through the housing.

(App. 67a).

On December 23, 1998, Petitioner Pocrass and co-plaintiff Amphenol filed a motion for summary judgment that Maxconn had infringed the claims of the '317 patent through the doctrine of equivalents. By Order dated February 16, 1999, the district court granted the motion for summary judgment of infringement of the '317 patent. (App. 44a-54a). In this Order, the district court again explicitly held that the claim as properly construed literally requires a one-piece wire construction:

> "Claim 1 also includes "a plurality of conductor wires, including conductor wires from said light emitting source, extending through one of said housing walls arranged in a predetermined spaced-apart array, adapted for insertion in a corresponding array of spaced holes in a printed circuit board." The Court interpreted this element as requiring that the wire extending from the LED through the housing wall be of one-piece construction"

(App. 48a, footnote 3).

But the district court further held that the two-piece wire construction of the accused device (*i.e.*, where the wires from the light emitting source were soldered to other wires which then extended out of the housing) was equivalent to the

one-piece wire construction claimed, and that the accused device infringed the claim through the doctrine of equivalents. (App. 50a-51a).

After a bench trial May 10 through May 15 1999, and June 7 through June 10, 1999, the district court issued Findings of Fact and Conclusions of Law, including an Order (App. 4a-43a), on March 7, 2000 entering judgments that, *inter alia*, the '317 Patent is invalid pursuant to 35 U.S.C. § 102(b) (App. 35a and 42a). In its Order, the district court again explicitly found that the claim required a one-piece wire construction:

> The major difference between the AMP Device and Claim 1 of the '317 patent is that the wires of the '317 patent's LED device are encased within the volume of the four walls of the housing. The wires leading from the LED to the rear of the device are not exposed, but are encased underneath the top (or bottom) wall. Because the wires are enclosed within the device they do not require insulation and *soldering to leads extending through the bottom wall, as with the AMP Device.*
>
> By placing wires outside of the housing the AMP Device presents potential drawbacks such as possible damage to wires and electrical "crosstalk." Also the assembly of the AMP device is more difficult in that the LEDs need to be press fit into the housing, insulation must be applied to the wires by hand, *and the wires from the LED must be soldered to the wires extending through the wall of the housing.*

(App. 14a-15a) (emphasis added).

Thus, the district court further explicitly found that the prior art (the "Amp device") did ***not*** include a one-piece wire construction as claimed, but instead used a two-piece wire construction. However, the district court noted its earlier summary judgment ruling that a two-piece wire construction is equivalent to a one-piece wire construction:

> Plaintiffs did not argue that a two-piece construction of the AMP Device LED wires took the device outside of the claims. This is not surprising in light of the Court's prior ruling that a two-wire construction could infringe the Claims. See Order Granting Summary Judgment at 4-7, dated February 16, 1999.

(App. 15a, footnote 4).

After construing the claim and characterizing the prior art, the district court then applied the construed claim to the prior art, discussing each element of the claim. However, when discussing the last paragraph of the claim, the district court simply stated:

> "The parties agree that the AMP Device meets this limitation."

(App. 35a).

The district court included no other discussion regarding the application of this claim limitation to the prior art. The court neglected to note that, to the extent there was any "agreement" that the claim limitation was satisfied, both parties were contending that this limitation was satisfied *only*

through equivalents. Petitioner (in its summary judgement motion) and Respondent (during the trial on validity) had both argued that a two-piece wire construction was equivalent to a one-piece wire construction. This was the basis for Respondent's assertion of anticipation.[1] Thus, even if the court were relying an "agreement" as opposed to its own clear factual findings, it was relying on equivalency in its holding of anticipation.

Petitioner Pocrass then filed an appeal to the Court of Appeals for the Federal Circuit on March 27, 2000 on behalf of himself and Amphenol Corporation, arguing that, among other things, the district court had explicitly found that the prior art did not include a feature of the claim as properly interpreted, but had apparently considered equivalency of that feature to suffice for purposes of an anticipation analysis. Respondent argued on appeal that petitioner had admitted that the last subparagraph of the claim was satisfied by the prior art. Respondent did not note that the alleged "admission" was made in the context of a proceeding in which both parties and the court were considering the applicability of the claim to a two-piece wire *through*

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1. *See, e.g.*, Trial Transcript, Vol. I, page 12, lines 12-18 where Respondent asserted this theory in its opening remarks. *See also* proposed finding of fact No. 35 submitted to the court by Respondent Maxconn on June 7, 1999, which reads:

> 35. Further, claim 6 concerns LED wires extending through the housing into the printed circuit board. *Even if one wire is soldered to another — as in the AMP device — it is under the doctrine of equivalents obviously one wire.*

(emphasis added).

equivalence, the alleged admission was made by a witness who professed not to be one of skill in the art, and the alleged admission was contrary to Respondent's own asserted position, *i.e.*, that the prior art used a two-piece wire that was *equivalent* to the claimed arrangement, not literally the same.

The Federal Circuit affirmed the lower court judgment in a Decision dated February 12, 2001 (App. 1a-3a). On the critical issue of whether or not the AMP Device satisfied the requirements of the last paragraph of the claim, the Federal Circuit stated only:

> Additionally, as pointed out by the district court, the Appellant's arguments regarding the "plurality of conductor wires" limitation were waived below, when the parties agreed that the AMP device met this limitation.

(App. 3a).

REASONS FOR GRANTING THE WRIT

Petitioner Alan Pocrass seeks review of the judgement below because: (1) reliance on equivalence in a holding of anticipation is without statutory authority and goes beyond any application of the doctrine of equivalents sanctioned by this Court, and (2) reliance on an alleged admission of fact which is clearly and directly contrary to the true facts as explicitly found by the court does not serve the interests of justice and should not be permitted, and a ruling from this Court is needed to clarify for all Circuit courts the treatment to be accorded evidentiary admissions in such circumstances.

I.

THE COURT IMPROPERLY RELIED ON EQUIVALENCE IN ITS ANTICIPATION HOLDING.

It is clear that the district court improperly relied on equivalence in its holding of anticipation. The district court made it clear in its rulings on claim construction and summary judgement, and reiterated in its Findings of Fact and Conclusions of Law at the end of the trial on validity issues, that the last subparagraph of the claim literally requires that wires from the light emitting source extend in a single piece from the light emitting source out through a wall of the housing. The district court also explicitly found that the prior art did not include this feature. The district court stated that this was an insignificant difference, citing to its summary judgement ruling on infringement where it had already held that a two-piece wire construction was equivalent to a one-piece wire construction. Indeed, Respondent Maxconn relied on the doctrine of equivalents in asserting its case for anticipation, and it is very clear from the district court proceedings and the rulings of the court that equivalency was central to its holding of anticipation.

The doctrine of equivalence, as established by this court, is for the purpose of preventing a fraud on the patent, and may have applicability in the context of an infringement analysis. The doctrine of equivalents was established long ago by this Court, and was refined in *Graver Tank & Mfg. Co., Inc., et al. v. Linde Air Products Co.*, 339 U.S. 605, 70 S. Ct. 854, 1950 U.S. LEXIS 2608, 94 L. Ed. 1097, 85 U.S.P.Q. (BNA) 328 (1950). The purpose of the doctrine is to prevent one from practicing a fraud on the patent. *Graver Tank*, 339 U.S. at 608. But the equitable considerations

giving rise to the doctrine of equivalents do not exist in the context of a validity analysis. Thus, equivalency cannot be relied on to support a finding of anticipation. The Federal Circuit has itself held that the fact that the prior art includes an equivalent to a claim element may be relevant to the issue of obviousness, but not anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1989 U.S. App. LEXIS 1684, 9 U.S.P.Q.2d (BNA) 1913 (Fed. Cir. 1989); *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747-48, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007, 108 S. Ct. 702, 98 L. Ed. 2d 653 (1988).

It is further noted that the doctrine of equivalents is to be applied after considering, among other things, the prior art. *Graver Tank*, 70 S. Ct. 856. It is well-settled that the doctrine of equivalents is not to be applied in such a manner that the claims covers the prior art, or even what would have been obvious in light of the prior art. *Wilson Sporting Goods v. David Geoffrey & Associates, et al.*, 904 F.2d 677, 684, 1990 U.S. App. LEXIS 8256, 14 U.S.P.Q.2d (BNA) 1942 (Fed. Cir. 1990). Thus, rather than rely on equivalency in an anticipation analysis, courts will instead simply limit the scope of equivalency available under the doctrine of equivalents. Holding anticipation based on an alleged equivalency contravenes this precedent, and should not be permitted, even under the guise of an admission (discussed below).

In letting the district court ruling stand, in the face of an ***explicit*** holding by the district court that the prior art does ***not*** include every element literally required by the claim, the Federal Circuit has upheld and condoned a finding of anticipation through equivalence. This is contrary to the law.

II.

HAVING EXPLICITLY HELD THAT THE PRIOR ART DOES NOT INCLUDE AN ELEMENT OF A CLAIM, THE COURT CANNOT RELY ON A TESTIMONIAL ADMISSION CONTRARY TO THIS EXPLICIT FACTUAL FINDING AND THEREBY HOLD THE CLAIM ANTICIPATED.

The district court in this case on plural occasions emphasized that the claim, as properly interpreted, literally required a one-piece wire construction. This interpretation of the claims is the province of the court as a legal matter. *Markman v. Westview Instruments*, 517 U.S. 370, 116 S. Ct. 1384, 134 L. Ed. 2d 577, 38 U.S.P.Q.2d (BNA) 1461 (1996). Whether a claim as properly interpreted is anticipated is a question of fact. *Atlas Powder Co., et al. v. Ireco, Inc.*, 190 F.3d 1342, 51 U.S.P.Q.2d (BNA) 1943 (Fed. Cir. 1999). On this latter issue, the district court explicitly held that the prior art does not include a feature of the claim, *i.e.*, the one-piece wire construction. This finding compels a holding of no anticipation. Even if the district court believed that petitioner had admitted to a contrary fact[2], the district court could not properly rely on this admission to establish a fact it **knows** and explicitly finds to be untrue.

As discussed earlier herein, what the parties and the court had agreed on was that a two-piece wire construction was equivalent to a one-piece wire construction. Respondent was

2. It is believed that the district court was not cognizant of any legal "admission", since the district court never used the term "admission" in any of its findings, but it appears that the district court was simply aware that both parties agreed that the two-piece construction was equivalent to a one-piece construction.

relying on the doctrine of equivalents to support its assertion of anticipation, and all of Respondent, Petitioner and the court knew and admitted that the prior art did NOT include a one-piece continuous wire. The district court mistakenly relied on an agreement of equivalency as a basis for its anticipation holding.

Since the court held that the claim required a one-piece wire construction, and the court found, and all parties agreed, that the prior art used a two-piece wire construction, proper application of 35 U.S.C. § 102 cannot result in a holding of anticipation.

The different circuit courts recognize a distinction between "judicial" admissions and "evidentiary" admissions. The former include, *e.g.*, admissions made in formal pleadings, and are conclusive and binding, since their purpose is to avoid the need for developing evidence. *Martinez v. Bally's Louisiana, Inc.*, 244 F.3d 474, 2001 U.S. App. LEXIS 4556 (5th Cir. La. 2001). The latter typically include, *e.g.*, testimonial admissions made at trial, and are treated at least as rebuttable. *Keller v. United States*, 58 F.3d 1194, 1995 U.S. App. LEXIS 16157 (7th Cir. 1995). But opinions of the different circuit courts are not clear on what type of rebuttal is necessary to overcome an evidentiary objection. In at least some circuits, an evidentiary admission is simply one piece of evidence to be weighed by the court. *Parkinson v. The California Co., et al.*, 233 F.2d 432, 1956 U.S. App. LEXIS 3168 (10th Cir. Wyo. 1956) ("convincing, persuasive or of little weight, according to the particular circumstances"). Under this standard, the "admission" in the present case would simply be ignored, since it is not true and is contrary to an explicit factual finding of the court. Other circuits allow the evidentiary admission to be

"controverted or explained by the party". *Martinez v. Bally*, 244 F.3d at 477; *Keller v. United States*, 58 F.3d 1194, 1995 U.S. App. LEXIS 16157 (7th Cir. 1995). But these courts are silent on the type of rebuttal needed, *e.g.*, whether the admission: (1) must be corrected after it is made or (2) can be rebutted by testimony or other evidence taken before the admission was made. Further, Petitioner has found no reported case from this Court or any circuit court which deals with the issue of what a court may or must do with an *evidentiary* admission that the court ***knows*** to be false, *i.e.*, where the admission goes to a fact that the court is as well or better equipped to determine than the party, *e.g.*, a fact that is already in the record.

It is believed that the proper rule for use of evidentiary admissions is that they should be considered as part of the evidence the court weighs in arriving at its conclusions. This leads to a correct and logical result in a case such as here where both parties agreed that the prior art had a two-piece wire construction, the court itself found that the prior art used a two-piece wire construction, and the court had ruled (and neither party was contesting at trial) that the claim literally required a one-piece wire construction, so that the parties and the court were all in agreement as to the facts which necessarily result in a finding of no anticipation. No evidentiary admission can outweigh such clear and consistent contrary facts.

There is precedent for holding against a party an admission as to a significant and operative fact, even if it turns out later that the admission was incorrect. But this is only in the case of an admission, such as an admission that occurs in the pleadings themselves, that amounts to a "judicial" admission. *See Jones, et al. v. Morehead*, 68 U.S.

155, 1863 U.S. LEXIS 451, 17 L. Ed. 662, 1 Wall. 155 (1863). This court has not defined a clear line of demarcation between judicial and evidentiary admissions. It is believed that a party's testimony at trial should generally be treated as an evidentiary admission, not as a conclusive judicial admission. *See, e.g., Keller v. United States*, 58 F.3d 1194, 1197 n.8, citing Michael H. Graham, Federal Practice and Procedure: Evidence at 6726, at 536-37, and John William Strong, McCormick on Evidence at 254, at 142 (1992). *See also* 9 Wigmore, Evidence at 2594a, at 834 & 844 (Chadbourn rev. 1981).

In the present case the alleged admission is a testimonial admission with regard to a fact already known to the court, and, importantly, already explicitly found by the court to be otherwise. To rely on an admission in this circumstance leads to a holding which is simply incorrect and, also not surprisingly, a result that is in other respects contrary to prior holdings of this court (*e.g.*, the requirement that a claim be interpreted the same way for both infringement and validity purposes). No evidentiary rule should foster knowingly incorrect rulings, and a ruling from this Court is necessary to ensure proper treatment of this circumstance in the Federal Circuit as well as to establish a uniform treatment of such circumstances in all circuits, thereby ensuring consistent and logical treatment of evidentiary admissions.

CONCLUSION

There are several ways to characterize the district court and Federal Circuit decisions in this case. One is that both the district court relied on equivalence in a holding of anticipation, and in its affirmance of the anticipation holding the Federal Circuit has also relied on equivalence. This is

contrary to the Federal Circuit's own precedent and is not supported by any precedent of this Court.

Another way to characterize the decisions is that the courts have not relied on equivalence in a finding of anticipation, but have instead relied on an admission. But the entire district court proceeding was conducted with the knowledge and agreement of all parties and the court that the claim required a one-piece wire construction, the prior art device included a two-piece wire construction, and that a two-piece wire construction was ***equivalent*** to a one-piece wire construction. Any "agreement" or "admission" would have to be taken in that context. Further, whether the alleged admission is as to a legal or factual issue, a rule which permits reliance on a testimonial "admission" to the exclusion of all other evidence can lead to a result, as it did here, that the court **knows** to be inconsistent with the facts and applicable law. If the admission is as to the scope of the claim, it is an admission by a party on a legal matter (claim construction) entirely within the province of the court, and should be rejected. Further, and importantly, acceptance and reliance on such an admission on claim construction leads to the result here that the claim has been interpreted differently for infringement and validity purposes, contrary to the precedent of this Court. *See White v. Dunbar*, 119 U.S. 47, 51, 7 S. Ct. 72 (1886); *Amazon.com, Inc. v. Barnesandnoble.com, Inc., et al.*, 239 F.3d 1343, 57 U.S.P.Q.2d (BNA) 1747 (Fed. Cir. 2001).

On the other hand, if the admission is to the factual issue of the content of the prior art, it contradicts the facts as known by all parties and as explicitly found by the court.

The alleged "admission" is at most an evidentiary admission that is not conclusive on the issue, and is clearly

inconsistent with other evidence and, most importantly, clearly inconsistent with the district court's own findings as to both the scope of the claims and the content of the prior art.. Under such circumstances, the alleged admission should simply be weighed with all of the other evidence, and, in this case, ignored as inaccurate. To allow otherwise is to invite courts to issue decisions known by the court to be inconsistent with fact and law, which cannot possibly serve the interests of justice and equity.

Respectfully submitted,

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APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED AND DECIDED FEBRUARY 12, 2001

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

00-1301

AMPHENOL CORPORATION,

Plaintiff,

and

ALAN L. POCRASS,

Plaintiff-Appellant,

v.

MAXCONN INCORPORATED,

Defendant-Appellee,

and

NU-WAY ELECTRONICS, INC.,

Defendant.

DECIDED: February 12, 2001

Appendix A

Before MAYER, *Chief Judge*, CLEVENGER and RADER, *Circuit Judges*.

CLEVENGER, *Circuit Judge*.

Alan L. Pocrass ("Appellant") appeals from a bench trial of the United States District Court for the Northern District of California, holding that Appellant's U.S. Patent No. 4,978,317 ("the '317 patent") is invalid as anticipated pursuant to 35 U.S.C. § 102(b). *Amphenol Corp. v. Maxconn, Inc.*, No. 97-20603 (N.D. Cal. Mar. 7, 2000). A previous order granting summary judgment that Defendant Maxconn, Inc., infringed the '317 patent was not appealed. *Amphenol Corp. v. Maxconn, Inc.*, No. 97-20603 (N.D. Cal. Feb. 16, 1999). We *affirm* the judgment of patent invalidity.

I

Appellant raises two main issues on appeal: (1) whether the district court erred in its interpretation of the limitations "housing" and "within said housing" in the claims of the '317 patent; and (2) whether the district court erred in its application of the previously-construed "plurality of conductor wires . . ." limitation during the invalidity determination phase of the trial.

This court reviews claim construction *de novo*. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995) (en banc) *aff'd*, 517 U.S. 370 (1996). "Anticipation is a factual matter, which we review under the clearly erroneous standard." *Glaxo, Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995).

Appendix A

II

We have fully reviewed the opinion of the district court, the arguments presented by the parties in their briefs, and the arguments made by the parties at oral argument.

For the reasons stated in the opinion of the district court, we agree that the '317 patent is invalid due to anticipation by the prior art "AMP device." Addressing the specific points raised by Appellant, we find that the "housing" limitations were properly construed by the district court to encompass a housing with a wall including a protrusion or flange. Additionally, as pointed out by the district court, the Appellant's arguments regarding the "plurality of conductor wires . . ." limitation were waived below, when the parties agreed that the AMP device met this limitation.

Therefore, the AMP device met all of the limitations of the claims of the '317 patent. The judgment of patent invalidity pursuant to 35 U.S.C. § 102(b) is affirmed.

No costs.

APPENDIX B — FINDINGS OF FACT AND CONCLUSIONS OF LAW OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA DATED, DECIDED AND FILED MARCH 7, 2000 AND ENTERED MARCH 8, 2000

UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF CALIFORNIA

CIVIL NO. 97-20603 SW

AMPHENOL CORP., et al.,

Plaintiffs,

v.

MAXCONN, INC., et al.,

Defendants.

* * *

March 7, 2000, Decided
March 7, 2000, Filed;
March 8, 2000, Entered in Civil Docket

* * *

FINDINGS OF FACT AND
CONCLUSIONS OF LAW

SPENCER WILLIAMS, United States District Judge.

Appendix B

This lawsuit brought by Plaintiffs Amphenol Corporation ("Amphenol") and Alan L. Pocrass ("Pocrass") against Defendant Maxconn Corp. ("Maxconn") went to bench trial from May 10 to May 14, 1999, and resumed June 7 to June 9, 1999. The trial covered two claims: (1) Maxconn's claim that the patent-in-suit, U.S. Patent No. 4,978,317 ("the '317 patent") is invalid; and (2) Plaintiffs' claim that Maxconn wilfully infringed the patent-in-suit.

Charles R. Wolfe, Jr., Bacon & Thomas, Alexandria, Virginia, appeared, pro hac vice, on behalf of Plaintiff Amphenol. Kevin P. Kane, Rubin, Eagan & Kane, Beverly Hills, appeared on behalf of Plaintiffs Pocrass and Amphenol. Daniel S. Mount, Alfredo Bismonte, and Leslie Hoekstra, Mount & Stoelker, San Jose, and Kimberly A. Donovan, Ropers, Majeski, Kohn & Bentley, appeared on behalf of Defendant Maxconn.

Broadly speaking, the claims of the '317 patent cover an electrical connector referred to as an RJ modular connector with a light emitting source held in place in the housing of the connector adjacent to the opening which receives the plug connection. The conductor wires, including those from the light emitting source, extend out through a housing wall, and are arranged in a predetermined spaced-apart array for insertion into a printed circuit board ("PCB").

The Court conducted a claim construction hearing on September 24, 1998 and thereafter issued its Order Construing Claims on November 20, 1998. In sum, the Court determined that:

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(1) the claims are limited to RJ type modular connectors;

(2) the light emitting source must be held in place in the housing of the connector such that the light emitting source is part of the connector unit; and

(3) a continuous conductive wire from the light emitting source extends out through the housing wall.

On December 23, 1998, Plaintiffs filed a motion for summary judgment, seeking an order finding that Maxconn had infringed the claims of the '317 patent as a matter of law. Maxconn had created an RJ modular connector with light emitting diodes (LEDs), wherein the LEDs could be removed from the connector housing. A wire from the removable LED joined with a second wire fixed within the housing to create a continuous electrical connection. After conducting a hearing on January 26, 1999, the Court granted the motion and held that Maxconn's offering its RJ modular jack with LED connector for sale infringed Claims 1, 2, 3, 5, 6, and 9 of the '317 patent. See Order Granting Summary Judgment, dated February 16, 1999.

The ruling on summary judgment left only two issues to be decided in the bench trial[1]: (1) Plaintiff's claim that Maxconn's infringement was willful, entitling them to an award of reasonable attorneys' fees; and (2) Maxconn's declaratory judgment counterclaim that the '317 patent is invalid and unenforceable.

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1. The parties agreed to have the issues resolved in a bench trial rather than a jury trial.

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II. FINDINGS OF FACT

A. The Parties

Plaintiff Amphenol is a Delaware Corporation, with its principal place of business in Wallingford, Connecticut. Amphenol is a non-exclusive licensee of Alan L. Pocrass under the '317 patent.

Plaintiff Pocrass is an individual residing in Simi Valley, California. He is the inventor, owner and licensor of the '317 patent.

Defendant Maxconn is a California corporation, with its principal place of business in San Jose, California.

Defendant Nu-Way Electronics, Inc. is an Illinois corporation having a place of business in Elk Grove Village, Illinois. It was dismissed from this action after agreeing to an injunction.

B. The '317 Patent

Pocrass filed an application with the United States Patent and Trademark Office on March 27, 1989, and the '317 patent was issued on December 18, 1990. The patent concerns an electrical connector known as an RJ-type modular connector commonly used in the data communication and telecommunications applications. In the '317 patent, the RJ connector is combined with at least one light emitting source, such as an LED, which is secured within a molded housing to form a single unit. The LED is placed on the front

wall of the housing adjacent to the plug receiving opening so as to provide visual verification of the status of the electrical connection. Pocrass invented this device to help solve two problems: to address space limitations imposed on manufacturers of PCBs, and to reduce the labor required to separately assemble RJ connectors and light emitting sources on a printed circuit board. The invention accomplishes these objectives by integrally securing the light-emitting source within the housing of the RJ connector defined by front, rear, top, and bottom walls. Wires from the connector, including wires from the light-emitting source, emerge through a wall of the housing in a predetermined spaced-apart array so that they can be inserted into an array of holes in a printed circuit board. (See Figure A below.)

By integrating the LEDs into the connector, valuable space could be saved on the customers' printed circuit board. The invention allowed for high component and connector densities on printed circuit boards. Second, labor costs were saved because LEDs did not have to be handled and mounted separately. The easier installation presents a cost savings to manufacturers.

The Court finds that Mr. James Hillis, expert witness for the Plaintiffs, is qualified as an expert on the design and manufacture of printed circuit boards. As Mr. Hillis testified, Mr. Pocrass' invention succeeded in reducing the space occupied by electronic components on a printed circuit board, and cut down on manufacturing costs associated with positioning and soldering each LED to the board. At the time of the Pocrass invention, the need to conserve space on a printed circuit board was well known.

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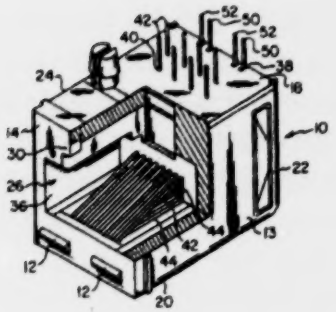

Figure A: Figure 1 from the '317 patent depicting "a perspective view, partially cut-away, of the electrical connector of the present invention." '317 patent at 2:16-17

Claim 1, the only independent claim of the '317 patent, reads as follows:

> 1. An RJ type modular connector for receiving a plug to form an electrical connection in data communication or telecommunication applications comprising:
>
> a housing formed by front, rear, top and bottom wall and having a plug receiving opening formed with the front wall thereof;
>
> at least one light emitting source integrally secured within said housing adjacent the plug receiving opening thereof to provide visual verification of the status of the electrical connection;

> a plurality of conductor wires, including conductor wires from said light emitting source, extending through one of said housing walls arranged in a predetermined spaced-apart array, adapted for insertion within a corresponding array of spaced holes in a printed circuit board.

'317 patent at 4:55-5:2.

From 1990 to 1995, Pocrass made some unsuccessful efforts to license his patent. On May 10, 1995, Pocrass and Amphenol entered into a license agreement granting Amphenol the nonexclusive right to make, have made, use and sell, or otherwise supply, products covered by the claims of the '317 patent. The license agreement also gave Amphenol the right to bring and prosecute lawsuits for infringement of the '317 patent in its own name. Amphenol agreed to make a lump sum payment and pay royalties based on future sales to Pocrass in consideration of the license.

A week later, on May 17, 1995 Pocrass executed a second license with the Whitaker Corporation, the parent company of AMP Incorporated ("AMP"), a large manufacturer of electrical connectors, for a "limited-exclusive" license subject to the existing Amphenol agreement.

Thereafter, Amphenol and AMP began marketing RJ connectors with LEDs under their respective license agreements with both remitting royalties to Pocrass based upon their sales. There is no question that Amphenol's version of the RJ connector with LEDs has enjoyed

tremendous financial success.[2] [TEXT REDACTED BY THE COURT.] While the revenue from the LED-less connector was less than stellar, the revenue from the RJ connector with LED skyrocketed, clearly owing to Amphenol's semi-exclusive license with Pocrass and Amphenol's ability to charge premium prices. The sales evidence shows a dramatic increase in demand for Amphenol's RJ connectors, whether with or without connectors. Expert testimony indicated that the increase in the need for RJ connectors in general were due to the increase in computer networking in the time period, and due to the industrywide shift from coax networking to twisted pair, a technology involving the use of RJ connectors. [TEXT REDACTED BY THE COURT.]

During the licensing negotiations between Pocrass and the Whitaker Corporation, AMP disclosed to Pocrass a 1984 customer drawing depicting an RJ connector with integrated LEDs known during this litigation as the "AMP Device." (See Figures C and D herein.) This device depicted in AMP customer drawing 554601 ("AMP Drawing") was manufactured and sold by AMP to AT&T beginning in 1985. (See Figure B herein.) This device is an RJ-type connector with five plug receiving openings and five corresponding LEDs which are press fitted in openings in the front plate of the connector.

Pocrass and his attorney did not know of the AMP Drawing or the corresponding physical connector at the time they prosecuted the Pocrass patent in 1989 and 1990. Plaintiffs have conceded that the AMP Drawing and AMP

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2. There was no evidence presented regarding AMP's sales of the patented product.

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Device are prior art that, had they been known to the inventor, would have been disclosed as prior art to the patent examiner. No party sought reexamination of the '317 patent following the revelations about the AMP Device and AMP Drawing.[3]

C. Prior Art

1. The AMP Device and AMP Drawing

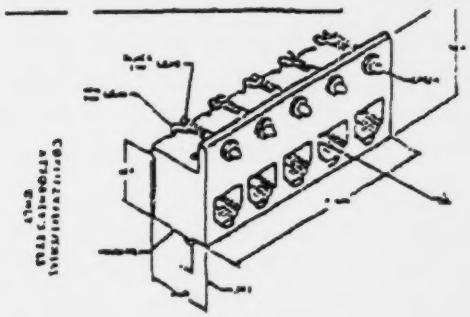

Figure B: Portion of the AMP Drawing depicting a perspective view of the device.

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3. Interestingly, in the course of the trial, Plaintiffs, advocating for a narrow reading of the claims of the '317 patent, appeared to assert that a device would not infringe the '317 patent in at least three circumstances:

> (1) where the LED protrudes even minimally above the top wall, because in that case the LED would not be "within" the housing;
>
> (2) where the device lacked a solid type of rear wall; and
>
> (3) where connector wires extended through the housing more than once.

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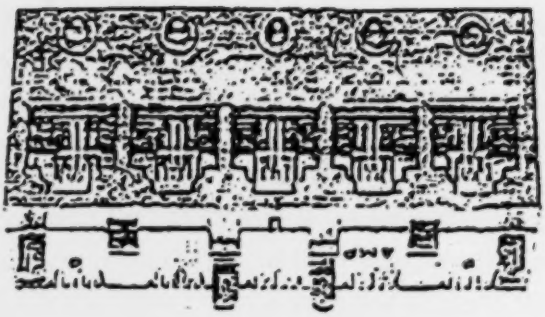

Figure C: The AMP Device, front and bottom view.

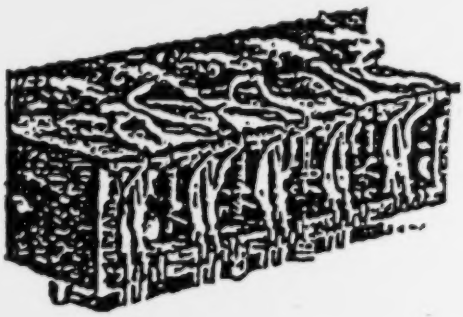

Figure D: The AMP Device, rear view.

A portion of the AMP Drawing is depicted in Figure B. Figures C and D show two views of the AMP Device. The AMP Device is an RJ-type connector with five plug receiving openings and five LEDs which are press fitted in an opening in a projection extending upward above the top wall of the connector.

The AMP Drawing shows a row of RJ connectors with an LED appearing above each plug receiving opening. The

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AMP Device itself is comprised of an RJ connector integrated with an LED to form a single unit. The front wall is taller than the rear wall. The LED is affixed within the upper portion of the front wall. The wires run from the LED along the top wall, but are not encased within or under the top wall. The wires then bend at a roughly 90 degree angle and are enclosed within the rear wall by little indentations. The LEDs on the AMP Device are positioned in the front wall near the plug receiving opening. The AMP Device serves the same function as the claimed invention, as it consists of a single unit which allows for quick and easy installation of the device onto the PCB and reduces the space occupied on the PCB.

The AMP Device incorporates LEDs in the RJ connector so that the LEDs are visually observed on the front wall of the connector next to the plug receiving openings; however, the front plate of the AMP Device is taller than that in the preferred embodiment of the '317 patent. The major difference between the AMP Device and Claim 1 of the '317 patent is that the wires of the '317 patent's LED device are encased within the volume of the four walls of the housing. The wires leading from the LED to the rear of the device are not exposed, but are encased underneath the top (or bottom) wall. Because the wires are enclosed within the device they do not require insulation and soldering to leads extending through the bottom wall, as with the AMP Device.

By placing wires outside of the housing the AMP Device presents potential drawbacks such as possible damage to wires and electrical "crosstalk." Also the assembly of the AMP device is more difficult in that the LEDs need to be press fit into the housing, insulation must be applied to the

wires by hand, and the wires from the LED must be soldered to the wires extending through the wall of the housing.[4]

AMP ceased production of the AMP Device, but no substantial credible evidence was presented as to why the AMP Device was not commercially successful.

2. The Clark Patent

United States Patent No. 4,379,606 ("Clark") describes a cartridge holder and connector system. The cartridge, which is not an RJ connector, sits atop a printed circuit board, and has a faceplate with two round openings for LEDs. The LEDs are attached to the printed circuit board and the cartridge assembly apparently is placed over the LEDs.

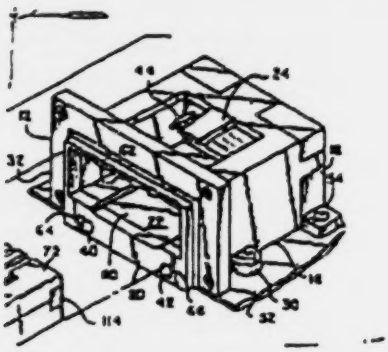

Figure E: A perspective view of the Clark patent cartridge holder, with LEDs (nos. 40, 42).

4. Plaintiffs did not argue that a two-piece construction of the AMP Device LED wires took the device outside of the claims. This is not surprising in light of the Court's prior ruling that a two-wire construction could infringe the Claims. See Order Granting Summary Judgment at 4-7, dated February 16, 1999.

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During the prosecution of the '317 patent, Pocrass and his attorney distinguished the Pocrass invention from Clark by emphasizing to the examiner that the LEDs in Clark are not integrally secured within the housing, as are the LEDs in the Pocrass invention. Clark does not teach the securement of LEDs within a connector housing.

3. The Lee Patent

United States Patent No. 4,618,917 ("Lee") describes a phone light accessory which is integrated into the handset of standard telephones. It was not located by Pocrass and was not shown to the PTO during the prosecution of the '317 patent.

The Lee patent is an RJ connector with LEDs integrally secured within the housing. However, the unit differs from the '317 patent in two important respects. First, the unit is not designed for insertion onto a printed circuit board. It does not have conductor wires which extend through a wall of the connector unit in a pre-determined spaced-apart array for inserting into corresponding holes in a printed circuit board. Second, the LEDs do not sit adjacent to the plug receiving opening. In one embodiment depicted in Figure 8 of the patent, lights are integrated into the top of a connector unit which is inserted into the telephone handset.

4. The Bogese II Patent

The U.S. Patent No. 4,457,570 ("Bogese II") discloses an RJ electrical connector or modular jack. The housing of the connector or modular jack has a plug receiving opening

in the front portion. The connector or modular jack supports an array of wires for insertion into a PCB. The patent, which covers a basic RJ connector, does not suggest integrating LEDs or visual indicators into the housing of the connector.

5. The Jordan Patent

U.S. Patent No. 4,065,198 ("Jordan") discloses an LED, and wires from the LED, secured in a small box-like housing or mounting with the LED wires insulated, for the most part, by the housing/mounting itself. The LED is in the front face of the housing/mounting. The wires from the LED extend through the bottom of the housing/mounting for insertion into a PCB.

6. German Patent No. DE 32 33 153 A1

This patent describes a connecting terminal clamp with wires for insertion into a PCB. It contains a voltage-indicating LED which may be integrated into the housing. The LED is not placed in the front wall adjacent to a plug receiving opening to inform the user whether a wire has voltage.

D. Level of Ordinary Skill in the Art

The '317 patent describes integrating an electrical RJ modular connector with an LED or other light emitting source to form one unit for insertion onto a PCB. Such a combination falls into the general art of connector and electronic packaging, and more specifically into the art of electrical connector design. A person of ordinary skill in

electronic connector design would have training in the nature of a BS degree in mechanical or electrical engineering, or at least the equivalent work experience, as well as a minimum of two years working in a technical capacity in a connector manufacturing company.

Defendant's expert Michael Lazar is qualified as one of ordinary skill in the art of connector design. Messrs. Hillis and Pocrass, witnesses for Plaintiffs, admitted to having no background, academic or professional, in that field. While they are qualified as experts on printed circuit board assembly, they are not qualified as experts on the subject of electrical connector design.

Lazar, president of the Connector Industry Consulting Group, gained experience in research, conception, design, development, testing and marketing of all types of connectors. Among other things, at the time of the application for the '317 patent, he was vice president, new product development, at the Burndy Corporation, a major manufacturer of connectors and related products.

E. Findings of Fact Relating to Willfulness of Infringement by Maxconn

In early to mid 1996, Maxconn developed a version of an RJ connector with integrated, but removable, LEDs, and consulted its outside patent attorney, Terry McHugh, about the potential for patenting the invention. McHugh, an experienced and knowledgeable patent attorney, closely supervised his associate George Yee during the patent search process. The search conducted by Yee and McHugh, though

competent and undertaken in good faith, did not result in the discovery of the '317 patent. This was because the '317 patent was categorized by the Patent Office in a way that McHugh and Lee did not anticipate.

In July 1996 Maxconn issued a press release about its version of the RJ connector with LEDs. Mention of the new product was included in Maxconn's product catalog and brochures, but Maxconn never made, used, or sold its product, and never tooled up for production.

In August 1996, Maxconn received a cease-and-desist letter from Amphenol informing it of the '317 patent and demanding that Maxconn stop the alleged infringement.

Upon receiving Amphenol's letter alleging infringement, Maxconn immediately sought McHugh's opinion. McHugh reviewed the '317 patent and its prosecution history, as well as the prior art in the field, and concluded that the Maxconn device did not infringe the '317 patent. He informed Maxconn and Amphenol of his conclusions in a detailed letter in which he distinguished the Maxconn device from the claimed invention.

At no time during the discussions with Amphenol had Maxconn tooled up for production. No functional unit was ever created. The photographs for the brochures were taken of non-functional prototype of the device. Maxconn notified its distributors and representatives to cease promotion of the Maxconn device. No accused device has been made or sold. Nor were any prices quoted or any representations made that the device was in fact available for sale.

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III. CONCLUSIONS OF LAW

Maxconn asserts that the '317 patent is invalid and unenforceable. The party asserting invalidity of a patent has the burden of proving invalidity. See ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577 (Fed. Cir. 1984). Maxconn asserts invalidity based on two grounds: (1) that the AMP Device anticipates the '317 patent, under 35 U.S.C. § 102; and (2) that the '317 patent is invalid for obviousness, under 35 U.S.C. § 103. Plaintiffs assert that Maxconn wilfully infringed the subject patent.

A. 35 U.S.C. Section. 102: Whether the Amp Device Anticipates the '317 Patent

A patent will be deemed invalid if it can be shown that the invention was not novel, but was anticipated. See 35 U.S.C. § 102. An invention is anticipated if it is identical to a prior reference. See Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565 (Fed. Cir. 1992); Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689 (Fed. Cir. 1985). To be identical, each and every element of the claimed invention must be disclosed in a single prior reference or embodied in a single prior art device. See In re Paulsen, 30 F.3d 1475, 1478 (Fed. Cir. 1994). In other words, "that which infringes if later, anticipates if earlier." Polaroid Corp. v. Eastman Kodak Co., 789 F.2d 1556, 1573 (Fed. Cir. 1986), citing to Peters v. Active Mfg. Co., 129 U.S. 530, 537, 32 L. Ed. 738, 9 S. Ct. 389 (1889).

A novelty determination involves consideration of the difference between the prior art and what is claimed. The

relevant prior art — the AMP Device — is described above. The Court must now construe the disputed elements of the claims, in order to visit the ultimate question whether the claims cover the AMP Device.

1. Construction of Disputed Claims in the '317 Patent

In the Order dated November 20, 1998, this Court construed various disputed elements of the claims of the '317 patent. At trial, the interpretation of the following additional terms of Claim 1 were called into question:

(1) "housing" and "within said housing";

(2) "front wall";

(3) "rear wall"; and

(4) "adjacent the plug receiving opening."

Plaintiffs argue that because the LEDs in the AMP device are placed on an upwardly extending projection which extends beyond the "housing" formed by the walls, they are not within the housing or adjacent the plug receiving opening in the front wall of the housing as required by Claim 1. Plaintiffs maintain that the latter claim element is particularly important in achieving one of the two primary goals of the invention — minimizing the space occupied by the RJ connector and LED.

Claim construction is a question of law to be decided by the court. See Markman v. Westview Instr., Inc., 52 F.3d

967, 979 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996). In interpreting a claim, the court should look first to the intrinsic evidence, consisting of "the patent itself, including the claims, the specification and, if in evidence, the prosecution history." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citing Markman, 52 F.3d at 979).

The first requirement in claim interpretation is to examine the claim language. See SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882 (Fed. Cir. 1988). Words in a claim will be given their ordinary meaning unless it appears that the inventor used them differently. See Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759 (Fed. Cir. 1984); Vitronics, 90 F.3d at 1582. The court interprets the words in a claim as one of ordinary skill in the art at the time of invention would understand them. See Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387 (Fed. Cir. 1992).

"A claim must be read in view of the specification of which it is a part." Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 621 (Fed. Cir. 1995). The specification can explain the language of the claims, but does not function to alter the scope of an invention as set forth by the claim language. See Markman, 52 F.3d at 980. The specification cannot in itself add an extraneous limitation to the claims. See E.I. Du Pont De Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433 (Fed. Cir. 1988).

The court may also consider extrinsic evidence, such as expert testimony. In those cases where the intrinsic evidence

unambiguously describes the scope of the patent, reliance on extrinsic evidence is improper. In such situations, extrinsic evidence, such as expert testimony, may not be used "for the purpose of varying or contradicting the terms in the claims." Vitronics, 90 F.3d at 1584.

a. "Housing"; "Within Said Housing"

Plaintiffs argue that the LEDs in the AMP Device are not "secured within the connector housing" defined by top, bottom, front, and rear walls. Plaintiffs argue that the LEDs sit exposed and unprotected on the projection above the housing formed by the walls. Defendant maintains that the LEDs are within the housing, on the front wall, as the claim does not limit the invention to a box-like structure with light emitting devices placed within the internal volume of the four specified walls.

i. The claim language

The claim requires that the LED lie "within" the "housing" as opposed to outside of the housing.

The claim reads that the housing is

> formed by front, rear, top and bottom walls and having a plug receiving opening formed within the front wall thereof.

'317 patent at 4:58-60. The light emitting devices must-be "within said housing":

> at least one light emitting diode integrally secured within said housing adjacent the plug receiving opening formed within the front wall thereof.

'317 patent at 4:61-63.

The housing, as described in the claims, is formed by four walls: front, rear, top and bottom walls. (The Claim does not require that the device have side walls.) The Code of Federal Regulations sets a standard for internal RJ plugs, but sets no standards or limitations describing the external configurations of RJ modular jacks. The issue disputed by the parties is whether a wall of the housing as defined in the claim can include a protrusion or flange, such as that found in the AMP Device. The claim language itself does not specify that the four walls of the housing must be "box-like" in structure or that the edges of the four walls must meet at the four corners at right angles. The claim does not require that the walls be of any particular shape or dimension, or that they be uniform in size.

With respect to devices (as opposed to residences), housing is generally defined as "something that covers or protects," "a casing (as an enclosed bearing) in which a shaft revolves," "a frame or other support for mechanical parts." See Webster's New Collegiate Dictionary 403 (7th ed. 1967).

ii. Specification

The specification states that the configuration of the RJ connector "is not a limitation to the present invention." The specification reads as follows:

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> It will be appreciated that an RJ connector is available in a variety of sizes, and internal configurations and may be molded in a number of ways commonly known in the art and is not a limitation to the present invention. The only requirement being that the RJ connector has a visible surface accessible for the placement of at least one LED indicator.

'317 patent at 4:23-29 (emphasis added). From this language it appears that the inventor intentionally left the definition of "housing" vague in order to capture within the claims the whole variety of RJ connector configurations known in the art.

iii. Prosecution history

The prosecution history does not provide assistance in defining "housing."

iv. Extrinsic evidence

Mr. Lazar presented credible testimony that housing is understood to be that which supports and insulates various other parts of the connector. He also testified that usually housing is a single molded unit.

v. Construction

Given the general and vague description of "housing" in the claim language, and the explicit statement in the specification that the specific molding of the RJ connector

is not a limitation to the invention, the Court finds that the "housing" could include a front wall with a protrusion or extension above the point where the wall meets the top or bottom walls. The broadly written claim does not require that the LED lie wholly within the volume created by four walls of housing. The housing must be a supporting structure made of a single molded unit, with a front, top, bottom, and rear wall.

b. "Front Wall"

A dispute arose during trial as to whether the claims contained a limit on the face plate (front wall) size. In addition, the parties disputed whether the "front wall" of the claim could include a "flange" extending beyond the point where the front wall met the top or bottom wall.

For the reasons set forth in part III(A)(1)(d), below, the Court finds the front wall size not fixed by the claims. For the reasons set forth in part III(A)(1)(a), above, the Court finds that a front wall need not be bordered by the point where top and bottom walls intersect the front wall.

c. "Rear Wall"

Plaintiffs argue that the AMP device does not have a rear housing wall as recited in Claim 1. They say that the back of the AMP device is completely open, exposing the conductor wires. Maxconn disagrees, stating that the claim does not require that the lead wires be enclosed under a solid rear wall.

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i. Claim language

The claim requires a "rear wall," '317 patent at 4:58, but does not contain any language describing the nature or design or this rear wall. The claim itself sets forth no limitation requiring that the conductor wires from the plug receiving opening be encased within a thick rear wall or behind a solid rear wall.

ii. Specification

Figures 3 and 4 of the '317 patent show a rear wall which is essentially just a square-like outline, the thickness of the top, bottom, and side walls, the vacant interior of the square exposing the wires and pins which connect the device to a printed-circuit board. Pocrass believes that Figures 3 and 4 contain a drafting error, and that the rear view in those figures was intended to be a cross section showing the wires placed behind or within a solid type of rear wall.

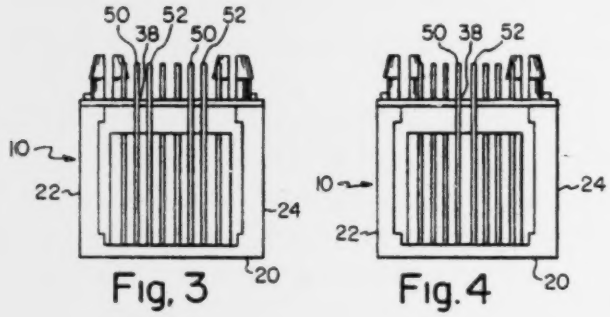

Figure F: Figures 3 and 4 of the '317 patent, showing rear views of the preferred embodiment (Figure 3 has two LEDs and Figure 4 has one LED).

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While Figures 1 and 2 of the '317 patent explicitly show cross-sections by means of the standard drafting technique of cross-hatching, Figures 3 and 4 contain no cross-hatching. Furthermore, Figures 3 and 4 would make no sense if the rear wall was understood as a cross-section, because it is clear that the electrical lead wires 50 and 52 lie within slots located on the outer portion of the rear wall. See Figure 1 of the '317 patent. If these figures represented true cross sections, items 50 and 52 would have been omitted.

The specification describes the rear wall as a structure that defines the rear of the plug opening, and which "extends transversely" across the rear of the housing:

> Opening 26 is further defined by a rear wall 16 which extends transversely across the rear portion of the housing 10. Outer rear wall surface has formed therein a plurality of alternating inwardly extending slots 38 which longitudinally extend within the rear wall 16 and top wall 18, FIGS. 3 and 4.

'317 patent at 3:16-21. The specification explains the claim term "rear wall" as that piece which lies at the rear of the plug receiving opening. The specification does not indicate that the rear wall somehow encloses all of the conductor wires. It is not specified that an encasement or wall must completely or even partially cover the wires extending from the light emitting source.

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iii. Prosecution History

The prosecution history does not help to clarify the meaning of rear wall.

iv. Extrinsic Evidence

Pocrass testified that Figures 3 and 4 of the '317 patent contained a significant mistake in the omission of the cross-hatching, therefore failing properly to indicate that these are cut-away or sectional views of the rear of the invention claimed under the '317 patent. Mr. Pocrass also testified that the written description of Figures 3 and 4 incorrectly failed to indicate that they are cut-away or sectional views.

The Court did not find Pocrass's testimony credible, or if credible, sufficient to overcome the clear import of the figures in the specification. Credible testimony was presented that RJ connectors were frequently made with open backs. As Mr. Lazar testified, the point was that there be a stopping surface to that the plug does not go through the back.

Plaintiffs stated that the Pocrass invention was essentially an adaptation of the Bogese II patent. Essentially the first claim of Bogese II mirrors the first claim of the '317 patent, without the light emitting devices. Figure 3 of the Bogese II patent "is a rear view of the preferred embodiment illustrated in FIG. 1." (See Figure G below.) The view shows the conductor wires exposed, but secured to the device at the top by indentations pressed into the outer edge of the top wall.

Appendix B

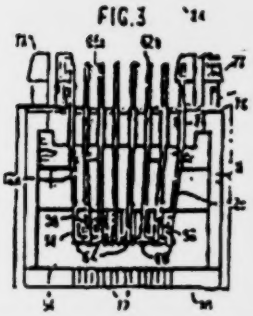

Figure G: Rear view of Bogese II patent preferred embodiment.

v. Construction

In conclusion, the "rear wall" described in Claim 1 need not be a solid rear wall, but can be an outline in which the interior wires of the device are left exposed. While Mr. Pocrass may have intended a different meaning for "rear wall," that meaning was not expressed in the patent itself. His self-serving testimony is given no deference.

d. "Adjacent the plug receiving opening"

Plaintiffs argue that the "adjacent" limitation requires that the light emitting source be visible in the front wall of the housing of the connector where the plug receiving opening is located, in close proximity to the opening. Maxconn argues that it means "near, close to or within a short distance of the plug receiving opening. This is in contrast to being remote from the plug receiving opening."

Appendix B

i. Claim Language

At least one light emitting source must lie "adjacent the plug receiving opening." '317 patent at 4:62-63. Adjacent means next to, nearby or within a short distance. Black's Law Dictionary defines "adjacent" as "Lying near or close to; sometimes, continuous; neighboring." Adjacent implies that the two objects are not widely separated, though they may not actually touch . . . while adjoining imports that they are so joined or united to each other that no third object intervenes." Black's Law Dictionary 41 (6th ed. 1990). Webster's defines adjacent as "near or close." Webster's New World Dictionary College Edition 16 (3d ed. 1988). "Adjacent things may or may not be in actual contact with each other, but they are not separated by things of the same kind . . . ; that which is adjoining something else touches it at some point or along a line . . . ." Id.

The purpose of the adjacency limitation is set forth within the claim: "to provide visual verification of the status of the electrical connection." '317 patent at 4:63-64.

ii. Specification

One possibility for the relative positions of the light emitting sources and the plug receiving opening is contained in Figures 1 and 2 of the '317 patent. Consistent with the word "adjacent," as opposed to the word "adjoining," the light emitting source does not share a common boundary with the plug receiving opening. The lights are neighboring, near, or close. The LEDs of the preferred embodiment (Figure 1 of the '317 patent) are positioned at some distance,

a millimeter or two, from the edge of the plug receiving opening, so that it appears that the lights correspond to electrical activity within the corresponding plug receiving opening.

The specification also indicates that "the connector 10 includes a visual indicator 12 integrated within the connector to provide visual verification of the status of the electrical connection." '317 patent at 2:39-42. In addition, the "Background of the Invention" section states that "The front wall has a plug receiving opening therein, and a light-emitting diode positioned within the front wall such that the light emitting diode provides visual verification of the status of the electrical connection." '317 patent at 2:5-9.

iii. Prosecution History

The prosecution history does not provide any guidance on this point.

iv. Extrinsic Evidence

Expert Lazar stated that adjacent means close to the plug receiving opening to indicate to the viewer that the LED correlates with that particular plug. While the Court found this testimony credible, it is unnecessary to consider it in light of the strength of the intrinsic evidence.

v. Construction

"Adjacent the plug receiving opening" means that the light emitting device is situated close to the plug receiving

opening such that (1) both the plug receiving opening and the light emitting device are in close proximity and are easily visible to the observer simultaneously; and (2) the observer could discern a relation between the plug receiving opening and the nearby lights. "Adjacent" was intended to signify not remote. Were a more precise limiting definition desired, the patentee could have used more precise language, such as "bordering on," or "abutting."

2. Application of Construed Claims to AMP Device

The Court concludes that the AMP Device anticipates Claim 1 of the '317 patent. The Court will discuss each limitation in turn.

- An RJ type modular connector for receiving a plug to form an electrical connection in data communication or telecommunication applications.

The parties agree that the AMP Device meets the above limitation.

- a housing formed by front, rear, top and bottom wall and having a plug receiving opening formed within the front wall thereof;

The Court concludes that the AMP Device has a housing formed by front, rear, top, and bottom walls and has a plug receiving opening formed within the front wall.

While Plaintiffs argue that the housing must be box-like and that the front of the AMP device features a protrusion or

flange, the Court concludes that the front wall which extends above the plane of the top wall is not a flange separate from the connector's housing. The claim is not so limited as to require a closed, box-like structure to constitute the housing.

The rear wall of the AMP structure, though not a solid covering, is a wall as contemplated by the Claim. The inner rear wall is a flat surface that serves as a stopping plate for the plug, and the outer portion of the rear wall is a flat surface around the perimeter of the rear of the housing, much like the rear wall in the '317 patent's preferred embodiment.

> • at least one light emitting source integrally secured within said housing adjacent the plug receiving opening thereof to provide visual verification of the status of the electrical connection;

The LEDs of the AMP Device are secured within the housing of the AMP Device. Claim 1 of the '317 patent defines housing broadly to encompass a variety of housing shapes, and the specification supports that view. A light secured to a protruding portion of the housing is still within the housing itself as contemplated in the patent claim.

The LEDs in the AMP Device are also "adjacent" the plug receiving opening, as required by the claim. Each light emitting diode in the AMP Device is located close to its corresponding plug receiving opening such that the observer can infer that the light from the diode indicates electrical activity taking place within the corresponding plug. Although the diodes lie a few millimeters further from the plug receiving opening than in Figure 1 of the '317 patent, the

increased distance is not so much so as to fall outside of the "adjacent" limitation.

> • a plurality of conductor wires, including conductor wires from said light emitting source, extending through one of said housing walls arranged in a predetermined spaced-apart array, adapted for insertion within a corresponding array of spaced holes in a printed circuit board.

The parties agree that the AMP Device meets this limitation.

In sum, the Court finds that the AMP Device, which was unknown to the inventor at the time he prosecuted the patent, and which was not revealed to the Patent Office during the prosecution, anticipates and renders invalid the '317 patent Claim 1 pursuant to 35 U.S.C. § 102 because the AMP Device contains all limitations set forth in Claim 1 of the patent. The Court does not make this determination lightly, and has spent several months reviewing the patent and the evidence submitted at trial. Maxconn has the better argument and has sustained its burden of proof. Mr. Pocrass intentionally cast a broad net around his claims, avoiding limiting the term "housing," and in doing so took the risk of ensnaring a piece of unknown prior art.

B. 35 U.S.C. Section 103: Whether the Prior Art Renders the '317 Patent Obvious

In the event that the Court has erred as to the 35 U.S.C. § 102 novelty issue, the Court will also examine — assuming

that the AMP Device LEDs are not "adjacent" the plug receiving opening or secured "within the housing" of the device — whether the invention of the '317 patent is obvious.[5] Maxconn argues that the invention would have been obvious to those of ordinary skill in the art, rendering the patent invalid pursuant to 35 U.S.C. § 103. Nonobviousness is a requirement for patentability under that statute. "Nonobviousness . . . means that an invention must not have been obvious to one with ordinary skill in the art to which the subject matter of the invention pertains at the time of the invention and in light of the teachings of the prior art." 2 Donald S. Chisum, Chisum on Patents ("Chisum"), § 5.01 (1994). "Nonobviousness is distinct from novelty in the sense that an invention may be obvious even though it is not identically disclosed anywhere in the prior art." Id.

Obviousness is a question of law based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the prior art and the claimed invention; and (4) extent of any objective indicia of non-obviousness. See Monarch Knitting Mach. Corp. v. Sulzer Morat GMBH, 139 F.3d 877, 881 (Fed. Cir. 1998). When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579 (Fed. Cir. 1997). The "absence of such a suggestion to combine is dispositive in an obviousness determination." Id. Whether motivation to

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5. It appears to be undisputed that the addition of a rear wall to a Bogese II-type RJ connector would have been an obvious modification of pre-existing art.

combine the references was shown is a question of fact. See In re Gartside, 203 F.3d 1305, 2000 WL 156565 *8 (Fed. Cir. 2000) (No. 99-1241).

Evidence of a suggestion, teaching, or motivation to combine prior art references may arise from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See 175 F.3d at 999. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Technology Corp., 121 F.3d 1461, 1472 (Fed. Cir. 1997), the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d 994, 999, overruled on other grounds, Gartside, 203 F.3d 1305, 2000 WL 156565 at *8.

Where the prior art consists of several previously existing patents, the test is whether there is anything which teaches or suggests that the patents and publications be combined to produce the claimed device. In re Jones, 958 F.2d 347, 351 (Fed. Cir. 1992).

The question here is whether one of ordinary skill would have been motivated to combine the references. The key references are Bogese II, the AMP Device, the Clark patent (the cartridge holder with freestanding LEDs nestled into the housing), the Jordan patent (the LEDs housed in a mounting with wires insulated and held in configuration by the housing wall), and the Lee patent (the RJ connector with integrated LEDs for use with telephone handsets). As to the German patent, the terminal block device is so dissimilar in structure and application to an RJ-type connector that it is

not reasonable to assert that one of ordinary skill in the art would rely on its teachings in designing an RJ connector for use in data transmission or telecommunications. To be considered prior art, a device must be "reasonably pertinent to the particular problem with which the inventor was involved." See In re Wood, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (Cust. & Pat. App. 1979).

The burden is on Maxconn to demonstrate that there existed at the time of the invention a suggestion to combine the references to create an RJ connector with LEDs integrated into the housing such that the LEDs are moved closer to the plug receiving opening, and the LED and conductive wires extending therefrom are fully encased within the volume of the four walls of the housing, with the wires insulated by the housing itself until such point that the wires extended through the housing for insertion into a printed circuit board.

The AMP Device and the Lee patent show that it was obvious to combine LEDs and RJ connectors in a single device. The Clark patent shows that it was obvious to place an LED in very close proximity to a plug receiving opening in electrical connectors generally. The Jordan patent shows that is was obvious to use housing or mounting to insulate and hold firm the wires extending from an LED. Missing from the evidence presented, however, is any suggestion to combine these references into one device such as the invention of the Pocrass '317 patent. There is no suggestion of the need to shrink the faceplate of the AMP Device,[6] place

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6. Plaintiffs maintained that the novel aspect of the '317 patent was that it incorporated LEDs into a standard RJ connector so that (Cont'd)

the LED snugly against the plug receiving opening, and use the housing itself to insulate and cover the LED wires.

The lack of this suggestion is dispositive of the obviousness determination. A novel combination of old mechanical elements that so cooperate as to produce a new and useful result, or merely a substantial increase in efficiency, can be patentable. In re Lunsford, 53 C.C.P.A. 986, 357 F.2d 380, 384 (C.C.P.A. 1966). "It is well established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references." Pro-Mold & Tool Co., Inc. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573 (Fed. Cir. 1996) (citing ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)).

Although it is unnecessary in light of the holding above, the Court will address the issue of secondary considerations. See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538 (Fed. Cir. 1983) (evidence of secondary considerations should be considered before a district court concludes that

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(Cont'd)
standard RJ connector dimensions could be maintained. However, as Plaintiff's expert Kent Bauldauf admitted, only the internal dimensions of RJ connectors are uniform — there are no standards governing the external housing. In fact, the dimensions of the Amphenol device based on the '317 patent, Defendant's exhibit 115, feature different external dimensions from those of the preferred embodiment of the '317 patent. The Amphenol device is squatter, with thinner walls, than the device depicted in the preferred embodiment of the '317 patent.

an improvement is obvious). Secondary considerations — long felt but unsolved needs, failure of others and commercial success of an invention — are indicia of nonobviousness. See Graham v. John Deere Co., 383 U.S. 1, 17-18, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966).

Commercial success provides a basis for inferring nonobviousness only when the success of a product is attributable to the feature that is the subject of the patent claim. See 2 Chisum § 5.05[2][f]. An increase in sales due to an increase in consumer demand arising from a change in markets or regulations, or due to aggressive marketing and discounting, is not necessarily an increase with a nexus to the patented feature. See id.

As indicated in the findings of fact, Amphenol's RJ connector with LED has enjoyed tremendous financial success. [TEXT REDACTED BY THE COURT.] The question is whether the success of the RJ connector with LEDs is owing to the innovative element — the integrated LEDs. Amphenol has shown a nexus with this innovative feature. They have shown that customers, and a continually increasing number of them, are willing to pay a premium to purchase the device with LEDs as opposed to a device without LEDs. While percentage growth of sales of the non-LED connector exceeded percentage growth of sales of the LED connector between 1997 and 1999 [TEXT REDACTED BY THE COURT.] the evidence shows that the connector with LED was very successful in the electronics market, as well as very profitable.

In sum, Maxconn has failed to prove by clear and convincing evidence that the claims of the '317 patent are

obvious, in that one of ordinary skill in the art would have arrived at the claimed invention solely based upon the teachings of the prior art. In addition, the evidence of commercial success bolsters Plaintiff's argument that the invention of the '317 patent was nonobvious.

C. Wilfullness of Infringement

The question of willfulness is one which is moot in light of the fact that the '317 patent is invalid. However, assuming the Court has erred in concluding that the '317 patent is invalid, Plaintiffs have failed to prove by clear and convincing evidence that Maxconn willfully infringed the patent.

Infringement is deemed willful under 35 U.S.C. § 284 when a person having knowledge of an adverse patent fails to exercise due care to avoid infringing that patent. See SRI Intern., Inc. v. Advanced Technology Laboratories, Inc., 127 F.3d 1462 (Fed. Cir. 1997). To exercise due care means that an infringer "acting in good faith and upon due inquiry, [has] sound reason to believe that it [has] the right to act in the manner that [is] found to be infringing." Id. The determination of whether an infringer exercised due care is based upon a totality of the circumstances test, which includes considerations of such factors as:

> (1) whether the infringer deliberately copied the patent;
>
> (2) whether the infringer, when he knew or should have known of the adverse patent,

reasonably investigated the scope of the patent and formed a good faith belief that the patent was invalid or was not infringed; and

(3) the infringer's litigation behavior.

See A.C. Aukerman Co. v. R. L. Chaides Constr. Co., 1993 U.S. Dist. LEXIS 17101, 29 U.S.P.Q.2d (BNA) 1054 (N.D. Cal. 1993). Also relevant is whether the infringer sought and heeded the advice of counsel. A person may reasonably rely upon the advice of counsel where the opinion offered meets certain objective standards. The opinion must be thorough and competent.

Maxconn took appropriate steps to try to locate the '317 patent. Its counsel's failure to locate that patent was not due to bad faith or incompetence, but was an honest error. Maxconn took appropriate steps to seek the advice of counsel upon receipt of Amphenol's cease-and-desist letter. The opinion of counsel rendered by Mr. McHugh that the Maxconn product did not infringe the '317 patent was competent, albeit in error (at least according to this Court's Order Granting Summary Judgment). Maxconn took sufficient steps to withdraw its offer for sale of an infringing product after learning of the possibility of infringement. Plaintiffs have failed to establish by clear and convincing evidence that Maxconn's infringement was willful.

CONCLUSION AND ORDER

(1) United States Patent No. 4,978,317 is invalid under 35 U.S.C. § 102 because it was anticipated by prior art.

(2) Assuming the patent was not anticipated by prior art, United States Patent No. 4,978,317 is not invalid for obviousness under 35 U.S.C. § 103.

(3) Assuming the patent to be valid, Defendant Maxconn, Inc. did not willfully infringe the patent.

Judgment shall be entered accordingly.

IT IS SO ORDERED.

DATE: MAR – 7 2000

SPENCER WILLIAMS
United States District Judge

APPENDIX C — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA GRANTING PLAINTIFFS' MOTION FOR SUMMARY JUDGMENT OF INFRINGEMENT OF U.S. PATENT NO. 4,978,317 DATED AND FILED FEBRUARY 16, 1999

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

CIVIL NO. 97-20603 SW

AMPHENOL CORP., et al.

Plaintiffs,

v.

MAXCONN, INC., et al.

Defendants.

ORDER GRANTING PLAINTIFFS' MOTION FOR SUMMARY JUDGMENT OF INFRINGEMENT OF U.S. PATENT NO. 4,978,317

This Order pertains to Plaintiff Amphenol Corporation's ("Amphenol") and Plaintiff Alan L. Pocrass' ("Pocrass") motion for summary judgment that Defendant Maxconn Corp. ("Maxconn") has infringed U.S. Patent No. 4,978,317 (" '317 Patent").[1] During the January 26, 1999 hearing, the

1. At the January 26, 1999 hearing, the Court DENIED Amphenol's motion for imposition of sanctions against Maxconn (Cont'd)

Appendix C

Court granted Plaintiffs' motion for summary judgment of infringement of the '317 patent. The present Order memorializes the reasons for that ruling.

BACKGROUND

Pocrass is the inventor and owner of the '317 patent. Amphenol is a licensee under the patent. This patent is directed to a particular type of electrical connector, known in the telecommunications and data networking industries as an RJ modular connector. One common example of an RJ modular connector is the ordinary telephone jack, typically mounted in a telephone or in a wall to receive the plug from a telephone line.

The Pocrass '317 patent teaches the integration of at least one light emitting diode (LED) on a connector unit to provide visual status verification of activity. The LED indicates, for instance, when a telephone is in use or if data is being transmitted or received. Prior to Pocrass' invention, LEDs were often used as visual status verifiers, but were typically placed separate and apart from the connector unit on the printed circuit board.

(Cont'd)
(docket no. 105). In addition, on February 5, 1999, the parties' informed that Court that they had reached a settlement resolving Maxconn's counterclaim that Amphenol had infringed Maxconn's U.S. Patent No. 4,857,017. Accordingly, Amphenol's motion for summary judgment of noninfringement of U.S. Patent No. 4,857,017 (docket no. 108) is DENIED as moot.

Appendix C

Plaintiffs assert that Maxconn has offered for sale a "modular jack with LED" product that infringes the patent. In response, Maxconn contends that its modular jack with LED lacks one element of the '317 patent: a one-piece wire extending from the LED through the connector housing wall. Maxconn also argues that it cannot be held liable for infringement because it has not made an "offer to sell" the allegedly infringing product.

Plaintiffs counter that the Maxconn device infringes under the doctrine of equivalents, and that Maxconn's marketing activities relating to the allegedly infringing product do constitute an "offer to sell" even though no sale has ever been consummated.

Plaintiffs seek to enjoin Maxconn from any further infringement of the '317 patent.[2]

LEGAL STANDARD

A party is entitled to summary judgment where there are no genuine issues of material fact that would require a trial. *See Celotex Corp. v. Catrett*, 477 U.S. 317 322-23 (1986). No genuine issue of material fact exists if the evidence "is of insufficient caliber or quantity to allow a rational finder of fact" to find for the nonmoving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 245 (1986).

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2. At oral argument, Plaintiffs stated that they no longer seek damages in this action.

Appendix C

DISCUSSION

A. Infringement Under the Doctrine of Equivalents

Patent infringement may be demonstrated by showing literal infringement or infringement under the doctrine of equivalents. *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, __, 117 S.Ct. 1040, 1049 (1997). In order to infringe under the doctrine of equivalents, the Maxconn jack must satisfy each limitation in the claim either literally or by equivalents. *See id.* An accused device cannot infringe, as a matter of law, if even a single limitation is not satisfied. *See Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934-35 (Fed. Cir. 1987) (in banc). In order to infringe under the doctrine of equivalents, the element must differ only insubstantially from the asserted claim limitation. *See Dawn Equipment Co. v. Kentucky Farms Inc.*, 140 F.3d 1009, 1015-16 (Fed. Cir. 1998); *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512, 1518 (Fed. Cir. 1995) (in banc), *rev'd on other grounds*, 520 U.S. 17 (1997)

In appropriate cases, a district court may determine that a device infringes under the doctrine of equivalents as a matter of law. The Supreme Court has stated, "[w]here the evidence is such that no reasonable jury could determine two elements to be equivalent, district courts are obliged to grant partial or complete summary judgment." *Warner-Jenkinson*, 117 S. Ct. at 1053 n.8 (citing Fed. R. Civ. P. 56 and *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986)).

In the present case, the Court concludes that the accused device, Maxconn's modular jack with LED, infringes under the doctrine of equivalents as a matter of law. "Whether an

element of the accused device is equivalent to a claim limitation depends on 'whether the substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element.' " *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1160 (Fed. Cir. 1998) (quoting *Warner-Jenkinson*, 117 S.Ct. at 1054). Known interchangability of the element in the accused product to the element in the patent claim is highly probative of equivalence. *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U.S. 605, 609 (1950); *Hilton Davis*, 62 F.3d at 1519.

Plaintiffs argue, and Maxconn does not dispute, that the only difference between the language of Claims 1, 2, 3, 5, 6, and 9 of the '317 patent and the accused Maxconn product is that in the Maxconn jack the conductor wire from the LED is not a one-piece continuous wire which extends from the LED out through the housing wall.[3] Rather, the conductor

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3. Claim 1 of the '317 patent states that the invention includes "at least one light emitting source integrally secured within said housing adjacent the plug receiving opening thereof to provide visual verification of the status of the electrical connection." The Court interpreted this element as not requiring that the LED be inextricably fused inside the connector housing. Rather, the term "integrally secured" means that the LEDs and connector move together as one unit. No permanency limitation is implied.

Claim 1 also includes 'a plurality of conductor wires, including conductor wires from said light emitting source, extending through one of said housing walls arranged in a predetermined spaced-apart array, adapted for insertion within a corresponding array of spaced holes in a printed circuit board." The Court interpreted this element as requiring that the wire extending from the LED through the housing wall be of one-piece construction.

wire which extends from the LED connects to a second conductor wire which extends out through a housing wall. The connection is accomplished by a clip which is attached to the end of the second wire and which engages the wire extending from the LED. Pocrass Decl., Ex. A3.

Plaintiffs argue that Maxconn's two-piece wire is both structurally and functionally equivalent to and achieves the same result as a one-piece continuous wire in the context of the RJ connector with visual indicator which is the subject of the '317 patent. *See* Pocrass Decl. ¶ 6 ("Joining two wires is both structurally and functionally equivalent to and achieves the same result as a one-piece continuous wire in the context of the RJ connector with visual indicator which is the subject of my patent."). Plaintiffs also argue that Maxconn's two-piece conductor wire is indisputably interchangeable with a one-piece conductor wire. Based on the above, Plaintiffs submit there is no reasonable basis upon which a jury would find that, in the context of the claims of the '317 patent, a two-piece conductor wire running from the light emitting source through the housing wall is not the substantial equivalent of a one-piece wire running from the light emitting source through the housing wall.

In an attempt to distinguish its device from the patented invention, Maxconn presented evidence in the form of a declaration of Maxconn engineer Greg Loudermilk. Loudermilk states that the two-piece wire "may not remain secured in place," and that the LED "may become disconnected, fall out, or otherwise fail to remain in place." Loudermilk Decl. ¶¶ 6,8. Loudermilk also states that the two-piece wire "may not provide the reliable conductivity"

of a single continuous wire, and that Maxconn's wire "could bend or fail to make an adequate connection with the clip due to lack of rigidity."[4] *Id.* ¶¶ 7,9.

As pointed out by Plaintiffs, Loudermilk's observations are speculative and hypothetical and fail to provide the type of evidence on which a reasonable jury could find a substantial difference between the accused device and the patent. Moreover, by presenting evidence that its two-wire design fails to assist in securing the LED within the housing, fails to maintain reliable connectivity, and fails to provide the longevity and reliability of one-piece construction, Maxconn makes the bizarre argument that, while the products may serve the same purpose, its product is simply inferior or defective when viewed in comparison to the patented product.

Maxconn does not dispute that a two-piece conductor wire performs substantially the same function, i.e., electrically connecting the LED to the circuit board, in substantially the same way, i.e., electrically continuous conductor wires, to achieve the same result, i.e., a connector with an integrated LED visual indicator electrically connected to the circuit board. Maxconn cannot escape an infringement charge by arguing simply that its design offers an inferior version of the patented product. *See, e.g., Weidman Metal Masters Co., Inc. v. Glass Master Corp.*, 623 F.2d 1024 (5th Cir. 1980)

4. Maxconn's assertion that the specification and prosecution history of the '317 patent suggest that the function of a single continuous wire is to achieve rigidity was specifically rejected by the Court in its order Construing Claims. *See* Order Construing Claims, p. 13, lines 3-25.

(court finds infringement where operation and results achieved by accused device were "essentially the same as those of the device disclosed by [the patent] save for inferior performance"); *Nasco Inc. v. Vision-Wrap Inc.*, 352 F.d 905 (7th Cir. 1965) (court finds infringement where accused device employed a "slightly inferior manner" to accomplish the same result in substantially the same way as the patented product).

In light of the substantial similarity between the simple wire element of the '317 patent and the two-part wire in the accused device, no reasonable jury could find that the accused Maxconn device does not infringe the '317 patent under the doctrine of equivalents.

B. Offer for sale

Next, Maxconn argues that it cannot be held liable for infringement because it has not made, used or sold the accused device, as required by 35 U.S.C. § 271(a). Patent infringement occurs when a person "without authority makes, uses, *offers to sell* or sells any patented invention." 35 U.S.C. § 271(a) (emphasis added).

It is undisputed that Maxconn never completed tooling, and that no samples, actual prototypes or actual products have ever been made, sold, or distributed. However, Maxconn did engage in some marketing activities. On July 10, 1996, Maxconn issued a product news press release regarding the accused device, providing a photograph of a non-operable mockup of the accused device and a general description of the product. The press release also advises

customers to "[c]ontact Maxconn directly or your local Maxconn representative or distributor for samples, availability, and pricing." In addition, Maxconn distributed a brochure entitled "Leading Edge Modular Jacks from Maxconn," containing a description of the accused device and stating that Maxconn "now offers" the products.

A recent case from the Federal Circuit, *3D Systems, Inc. v. Aarotech Laboratories, Inc.*, 160 F.3d 1373 (Fed. Cir. 1998), raised the question of what constitutes an "offer to sell" under the statute in the context of determining the existence of personal jurisdiction over a party. The court stated:

> This case presents an issue of first impression, as the phrase "offer to sell" was recently added to § 271(a) to conform United States law to the April 1994 Uruguay Round's Trade-Related Aspects of Intellectual Property (TRIPS) agreement. *See* Uruguay Round Agreements Act, Pub.L. No. 103-465, § 533(a)(1), 108 Stat. 4809, 4988 (1994). Additionally, a new subsection, § 271(i), was added defining an "offer for sale" or an "offer to sell" as "that in which the sale will occur before the expiration of the term of the patent." *See id.* § 533(a)(5); *see also* 5 Donald S. Chisum, *Chisum on Patents* § 16.02(5)(g), at 16-59 (1998) . . . . The amendment to § 271(a) represents a distinct change to the bases for patent infringement, because liability arose previously only as the result of an actual sale. *See, e.g., Telectronics Pacing Sys., Inc. v. Ventritex, Inc.*, 982 F.2d 1520,

> 1523, 25 U.S.P.Q.2d 1196, 1198 (Fed. Cir. 1992) ("The language of [section] 271(a) clearly specifies only the making, using or selling of a patented invention as infringing activities."). Little interpretation of this change as it relates to direct infringement under § 271(a) has been given, and no guidance on whether state law applies when determining if an "offer to sell" has occurred.

3D Systems, 160 F.3d at 1378.

Maxconn argues that the common law of contracts provides the best guidance as to the meaning of "offer to sell" in § 271(a). However, this argument was explicitly rejected in *3D Systems*, where the court held that the state common law of contracts was not relevant to the definition of "offer to sell" under the federal statute, and that "[t]he statutory character of the 'offer to sell' requires us to 'look back to federal law on the conceptualization' of the 'offer to sell' itself." *Id.* at 1379.

Applying federal law, the court went on to explain that one of the purposes of adding "offer[ ] to sell" in § 271(a) was to prevent generating interest in a potentially infringing product to the commercial detriment of the rightful patentee. *Id.* While Maxconn appears to concede that its marketing activities were aimed at generating interest in their modular jack with LED product, it argues that its marketing activities do not rise to the same level as those in the *3D Systems* case. The Court disagrees. While the accused infringer in *3D Systems* provided customers with price quotations and Maxconn did not, Maxconn's activities clearly characterized the phone

jacks as actual products, and Maxconn indisputably engaged in activities to generate interest in its new "product," just as the defendant had done in *3D Systems*. Accordingly, the Court concurs with Plaintiffs that Maxconn had undertaken a legally cognizable "offer to sell."

CONCLUSION

No genuine issue of material fact exists as to whether Maxconn has infringed the '317 patent under the doctrine of equivalents. Plaintiffs' motion for summary judgment that Maxconn has infringed U.S. Patent No. 4,978,317 (docket no. 106) is GRANTED.

IT IS SO ORDERED.

DATE: 2/16/99

s/ Spencer Williams
SPENCER WILLIAMS
United States District Judge

APPENDIX D — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA CONSTRUING CLAIMS DATED, DECIDED AND FILED NOVEMBER 20, 1998

UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF CALIFORNIA

CIVIL NO. 97-20603 SW

AMPHENOL CORP., et al.,

Plaintiffs,

v.

MAXCONN, INC., et al.,

Defendants.

* * *

November 20, 1998, Decided
November 20, 1998, Filed

* * *

ORDER CONSTRUING CLAIMS

SPENCER WILLIAMS, United States District Judge.

On September 24, 1998, the Court held a claim construction hearing in the above-captioned matter. Plaintiff Alan L. Pocrass ("Pocrass") is the inventor and owner of

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United States Patent No. 4,978,317 ("Pocrass '317 patent") and Plaintiff Amphenol Corp. ("Amphenol") is a licensee under the patent. Plaintiffs assert that Defendant Maxconn, Inc. ("Maxconn") has produced electrical connectors that infringe the patent. In a counterclaim, Maxconn asserts that Amphenol has produced electrical connectors that infringe its United States Patent No. 4,857,017 ("Maxconn '017 patent"). Having considered the briefs submitted and the oral arguments of counsel, the Court now interprets the patent claims as follows.

OVERVIEW OF THE PATENTS

A. Pocrass '317 Patent

This patent is directed to a particular type of electrical connector, known in the telecommunications and data networking industries as an RJ modular connector. The most common example of an RJ modular connector is the ordinary telephone jack, typically mounted in a telephone or in a wall to receive the plug from a telephone line.

The inventive idea contained in the Pocrass '317 patent is the integration of at least one light emitting diode (LED) on the connector unit to provide visual status verification of activity. The LED indicates, for instance, when a telephone is in use or if data is being transmitted or received. Prior to Pocrass' invention, LEDs were often used as visual status verifiers, but they were typically placed separate and apart from the RJ connectors on the printed circuit board.

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B. Maxconn '017 Patent

The Maxconn '017 patent concerns an electrical connector that includes a device for supporting and stabilizing contact wires at the end of the connector so as to reduce the possibility of contact damage during insertion of the contact into a printed circuit board or other connector. The patented device includes a locking support member, resembling somewhat a thick comb with staggered teeth, which may be coupled to the connector body to provide support for the wires.

LEGAL STANDARDS FOR CLAIM CONSTRUCTION

Claim construction is a question of law to be decided by the court. See Markman v. Westview Instr., Inc., 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996).

In interpreting a claim, the court should look first to the intrinsic evidence, consisting of "the patent itself, including the claims, the specification and, if in evidence, the prosecution history." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citing Markman, 52 F.3d at 979). The first requirement in claim interpretation is to examine the claim language. SmithKline Diagnostics v. Helena Lab., Corp., 859 F.2d 878, 882 (Fed. Cir. 1988). Words in a claim will be given their ordinary meaning unless it appears that the inventor used them differently. Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759 (Fed. Cir. 1984). In addition, a number of canons, such as the doctrine of claim

differentiation, guides construction. Athletic Alternatives, Inc. v. Prince Mfg., Inc., 73 F.3d 1573, 1578 (Fed. Cir. 1996).

In those cases where the intrinsic evidence unambiguously describes the scope of the patent, reliance on extrinsic evidence is improper. In such situations, extrinsic evidence, such as expert testimony, may not be used to interpret the claim language. Vitronics, 90 F.3d at 1584.

DISCUSSION

A. The Pocrass '317 Patent

Claim 1 of the Pocrass '317 patent is set forth below. The parties dispute the meaning of the underlined language:

> 1. An RJ type modular connector for receiving a plug to form an electrical connection in data communication or telecommunication applications comprising:
>
> a housing formed by front, rear, top and bottom wall and having a plug receiving opening formed with the front wall thereof;
>
> at least one light emitting source integrally secured within said housing adjacent the plug receiving opening thereof to provide visual verification of the status of the electrical connection;
>
> a plurality of conductor wires, including conductor wires from said light emitting source,

> extending through one of said housing walls arranged in a predetermined spaced-apart array, adapted for insertion within a corresponding array of spaced holes in a printed circuit board.

Pocrass '317 patent, col. 4:55-68, col. 5:1-2.

1. Whether the claim is limited to "RJ type modular connectors"

The parties dispute whether the specification indicates that the invention is directed to RJ type modular connectors in particular or electrical connectors in general. While "RJ type modular connectors" are mentioned in the preamble, Maxconn asserts that the language does not function as a limitation, and that the claims themselves describe the particular connector of the invention. Conversely, Plaintiffs argue that the claim should be read as limited to RJ type modular connectors.[1]

The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." Corning Glass Works v. Sumitomo Electric U.S.A., 868 F.2d 1251, 1257 (Fed. Cir. 1989). Where a patentee uses the claim preamble to recite structural limitations of his claimed invention, the PTO and courts give effect to that usage.

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1. An RJ modular connector is a specific type of electrical connector which receives a plug containing several conductor wires to form an electrical connection with each wire.

See id. On the other hand, where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation. See Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620 (Fed. Cir. 1995); Kropa v. Robie, 38 C.C.P.A. 858, 187 F.2d 150, 152 (C.C.P.A. 1951). To determine whether the preamble provides a limitation to the invention claimed, the court should assess whether the claim preamble gives "life and meaning" to the claims. See Kropa, 187 F.2d at 152. The court may look to the patent specification to determine whether the claimed invention includes preamble recitations. See Bell Communications, 55 F.3d at 621; Vaupel Textilmaschinen KG v. Meccanica Euro Italia SPA, 944 F.2d 870, 880 (Fed. Cir. 1991); Corning Glass Works, 868 F.2d at 1257.

In the Pocrass '317 patent, the patentee uses the claim preamble to recite structural limitations of the claimed invention. The specification makes it clear that the invention of the '317 patent is limited to electrical connectors known as RJ type modular connectors. As background to the invention, the inventor repeatedly states that his invention relates to RJ connectors. Pocrass '317 patent, col. 1:12-25. The inventor also states that he has "invented an RJ connector with at least one LED integrated into the module," Pocrass '317 patent, col. 1:26-27, and that "it is the object of the present invention to provide an RJ connector including an LED formed integral therewith," Pocrass '317 patent, col. 1:45-47. In addition, in the prosecution history, the term RJ type connector was specifically relied upon in arguments to distinguish the claims over the prior art.

Accordingly, the claim should be construed such that "RJ type modular connectors" serves as a limitation to the claim. The Court adopts Plaintiffs' interpretation as follows: "a connector for receiving a plug to form an electrical connection of the type referred to as an RJ modular connector." At oral argument, Maxconn did not dispute this interpretation.

2. "Integrally secured"

Claim 1 states that the invention includes "at least one light emitting source integrally secured within said housing adjacent the plug receiving opening thereof to provide visual verification of the status of the electrical connection." The parties dispute the meaning of this part of the claim. Maxconn asserts that the term "integrally secured" means "permanently secured" such that the LED cannot be removed from the connector unit. "Secured," it argues, connotes a sense of permanence while "integrally" signals that the LED is not secured in a removable or insubstantial way, but forms an inseparable single unit.

a. Claim language

To interpret the disputed language, the court first looks to the words of the claims to define the scope of the patented invention. See Vitronics, 90 F.3d at 1582. As stated above, words will be given their ordinary and accustomed meaning unless it appears that the inventor used them differently. Envirotech Corp., 730 F.2d at 759.

Plaintiffs argue that Maxconn is seeking to have the Court adopt a claim interpretation that includes additional,

unclaimed limitations which are not required by the ordinary meaning of the claim language, the patent specification, or the prosecution history. They argue the term "integrally secured" should be given its ordinary meaning as denoting that the LED is held in place within the housing of the connector so as to form a part of the connector unit. Plaintiffs strongly dispute that the LED and housing must form one inseparable unit.

The Court agrees with Plaintiffs. Nothing in the ordinary meaning of the term "integral" indicates that the parts must be permanently fused together. The ordinary meaning the term "integrally secured" suggests that the RJ connector housing and the LEDs move together as one unit, and not that the LEDs cannot, with some degree of effort, be extracted from the housing.[2] Nothing in the claim language itself denotes a "permanency" limitation.

b. Specification

The second step in the analysis is to review the specification to determine whether the inventor has used any

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2. Plaintiffs argue that the Court of Appeals for the Federal Circuit has in at least one instance interpreted the ordinary meaning of the term "integral" and held that it does not denote one piece. In re Morris, 127 F.3d 1048, 1055-56 (Fed. Cir. 1997). Following oral argument, Defendant submitted with leave of Court a brief arguing that the Morris analysis is irrelevant to the present matter. The Court agrees that the Morris analysis is certainly less relevant to the present claims construction than is the intrinsic evidence now before it. Because the Court relies entirely on intrinsic evidence to interpret this phrase, it does not reach the question whether Morris should be considered persuasive authority on the interpretation of the word "integral."

terms in a manner inconsistent with their ordinary meaning. See Vitronics, 90 F.3d at 1582. The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication. See id. (citing Markman, 52 F.3d at 979). It is the single best guide to the meaning of a disputed term. Id.

Extraneous limitations appearing in the specifications should not be read into a claim. See E.I. DuPont De Nemours & Co. v. Phillips Petro., 849 F.2d 1430, 1433 (Fed. Cir. 1988); see also Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 867 (Fed. Cir. 1985) ("Generally, particular limitations or embodiments appearing in the specifications will not be read into the claims."). "Extraneous" refers to a limitation read into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim. DuPont, 849 F.2d at 1433.

The specification of the Pocrass '317 patent is consistent with the interpretation that "integrally secured" does not require that the LED be permanently secured within the connector housing so as to form an inseparable unit. The specification states that "an opening may be molded in the modular style connector and then the LED indicator placed therein and adhesively cemented in place, if needed." Pocrass '317 patent, col. 4, ll. 7-10 (emphasis added). The specification thus teaches that fixing the LED with adhesive is optional. The specification also indicates that the LED indicator is "placed" inside the connector housing, and nowhere indicates that the LED is inextricably fixed inside the housing.

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Because the specification does not include a "permanency" limitation, that limitation should not be read into the claim.

c. Prosecution history

Next, the court considers the prosecution history of the patent. The history contains the complete record of all proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claim. See Vitronics, 90 F.3d at 1582. The prosecution history limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance. See Specialty Composites, 845 F.2d 981, 988 (Fed. Cir. 1988). Patent claims may not be interpreted one way in order to obtain their allowance and a different way against accused infringers. Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576 (Fed. Cir. 1995).

During the prosecution of the patent, the examiner noted the similarity of certain aspects of the invention to a device disclosed in the prior art. The prior art was a patent issued to Clark for a cartridge holder and connector system. In responding to the patent examiner, one of the ways Pocrass distinguished the claims of the '317 patent over the system disclosed by the Clark patent was that the LEDs in his invention are "integrally secured" within the connector housing in the claims. Pocrass based his distinctions on the fact that in the Clark device, the LEDs are not secured in any way to the housing of the device to form an integral

unit, but instead are secured to the PC board. In that device, the connector housing slides over the tops of the LEDs.

Defendant argues that the examiner required the addition of the phrase "integrally secured" to distinguish the feature of the Clark patent where the LEDs slid into indentations in the connector housing. However, a close reading of the history reveals that the phrase "integrally secured" was meant to distinguish the fact that the LEDs in the Clark patent were secured to a location remote from the RJ connectors. The history further reveals that the patentee intended the LEDs to be "integrally secured" "by injection molding or by other adhesive or mechanical means within the housing." Amendment mailed December 28, 1989 at 7. Pocrass explained that Clark's LEDs were "merely are slid into open indents" and that those indents "[do not] integrally secure the . . . LEDs within the housing. . . . [The] LEDs [ ] are positioned on the PC board [ ], and the housing member [ ] is slidably placed over the tops thereof." Amendment mailed December 28, 1989 at 7. In other words, if the housing of the Clark device is removed from the PC board, the LEDs will stay in place on the board because they are not an integral part of the housing.

The prosecution history demonstrates that "integrally secured" means that the LEDs move as one unit with the housing of the connector as opposed to being fixed on the PC board as in Clark. Therefore, the Court finds that the prosecution history does not limit the interpretation of claim 1 so as to require that the LEDs be permanently fixed within the housing so as to form an inseparable unit. Rather, the term "integrally secured" means that the connector body and LEDs move together as one unit.

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d. Extrinsic evidence

There is no need for the Court to consider any extrinsic evidence as to this phrase.

e. Interpretation

The Court adopts Plaintiffs' interpretation as follows: "The light emitting source is held in place in the housing of the connector near the opening in the front wall which receives the plug so that the light emitting source is a part of the connector unit."

3. "Wires . . . extending through"

The parties next dispute the meaning of the phrase in Claim 1: "wires, including conductor wires from said light emitting source, extending through one of said housing walls."

a. Claim language

Maxconn argues that the ordinary meaning of the claim language indicates that the conductor wire from the light emitting source itself extend through a wall of the housing with no intervening connections. Plaintiffs, conversely, argue that the claim contains no limitation that the wire be formed of one continuous strand originating at the LED. They say that regardless of whether the wire is formed of one continuous strand or more than one strand joined end-to-end, it remains a conductive wire from the light emitting source.

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The Court agrees with Maxconn that the claim language itself suggests that a single strand of conductive material extends from the LED itself out through an opening in the housing wall. While it is common knowledge that the term "wire" includes materials that are in actuality composed of more than one piece of conductive filament laid more or less end to end (e.g., telephone wires, cable wires, and electrical wires), this particular claim relates to a very short segment of wire, not one stretching over feet, yards, or miles. While two pieces of wire joined end-to-end may serve the precise functional equivalent of a single wire, the ordinary meaning of the claim is that one continuous piece of wire extends from the LED out through the housing.

b. Specification

Maxconn argues that the specification describes a continuous LED wire passing through, along, or above various walls in the connector and plugging into the printed circuit board. Plaintiffs do not genuinely dispute this, but argue that the limitations of the specification should not be read into the claim. The Court agrees with this point of law. See E.I. DuPont De Nemours, 849 F.2d at 1433 (limitations of the specification should not be read into a claim).

Plaintiffs also argue that the specification states explicitly that the internal wiring can be accomplished in a variety of ways and is not a limitation to the invention. The Court disagrees. While it is true that the specification provides that "RJ connector[s] [are] available in a variety of sizes and internal configurations and may be molded in a number of ways commonly known in the art and is not a

limitation to the present invention," Pocrass '317 patent, col. 4:24-27, this language refers explicitly to configurations of RJ connectors "commonly known in the art," and not to the novel and nonobvious improvements contained in the Pocrass '317 patent. The key novel and nonobvious improvement is the incorporation of an LED connected to a wire which extends through the connector housing. Accordingly, the quoted passage from the specification does not explicitly refer to LED wiring methodologies.

c. Prosecution history

Maxconn argues that the prosecution history reveals that the patentees, to promote the goal of achieving certain rigidity and spacing, specifically called for the patent to include one piece of wire running from the LED to the printed circuit board. Plaintiffs on the other hand argue that rigidity and spacing features refer to the relationship between the wires and the housing wall, and not to any requirement that the wires each be of one-piece construction.

The Court has no trouble agreeing with Plaintiffs. The prosecution history reveals that Pocrass distinguishes his invention from the Clark device by pointing out that the LEDs in Clark are positioned directly on the printed circuit board such that no wires from the LEDs go through a wall of the connector housing which is simply slid over the LEDs. Pocrass states: "The conductor wires from the LED device of Clark et al. do not extend through a wall of the device as required in the present claims." Amendment mailed December 28, 1989, at 7. "This claimed feature provides rigidity to the conductor wires and provides the required

predetermined spaced array for subsequent insertion in a like array of holes presented in a printed circuit board." Amendment mailed December 28, 1989, at 7.

Accordingly, the prosecution history, while it does not develop Plaintiffs' proposed construction, also fails to support Maxconn's proposed construction.

d. Extrinsic evidence

The parties have not submitted any extrinsic evidence which illuminates the meaning of this disputed phrase.

e. Interpretation

The Court concludes that nothing in the specification or prosecution history serves to alter the plain meaning of the subject phrase. Accordingly, the Court construes the terms as meaning that a continuous wire extends from the light source out through the housing wall.

B. The Maxconn '017 Patent

Claim 1 is set forth below. The parties dispute the meaning of the underlined language:

1. A multiple contact connector comprising,

a connector body having a body interior and have a front mating surface and an open-end body cavity,

a plurality of angulate contact elements, each contact element having a first and second rectilinear segments and an angulate segment coupling said rectilinear segments, said first rectilinear segments fixed to the front mating surface in an array of at least two rows, said second rectilinear segments arranged at an angle to the first segments in at least two rows in an alternating fashion relative to a plane extending parallel to said second rectilinear segments through a base coupling surface, and

a locking reinforcement support member having a mating means for selectively engaging said connector body at said open-end body cavity, said locking support member having a plurality of teeth spaced apart to define indentations, said indentations each being partially defined by rearward walls, said rearward walls having a staggered distance relative to said front mating surface when said locking support member engages said connector body, each indentation correspondingly housing and supporting a portion of a second rectilinear segment and a portion of an angulate segment of a contact element when said locking support member is brought into mating engagement with said connector body . . . .

The other independent claim of the Maxconn '017 patent, Claim 6, reads in pertinent part as follows (with disputed terms underlined):

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6. A support device for portions of angulate contact elements within an interior of a multiple contact connector having a front mating surface, opposed lateral surfaces, a cover surface, a base surface and an open-end body cavity, said multiple contact connector further having means for unaidedly securing said angulate contact elements, said angulate contact elements secured for attachment to a first external article at said front mating surface and to a second external article at said base surface, said support device comprising,

a locking reinforcement support member slidably fit within said open end of said body cavity defined in said multiple contact connector, said open end of the body cavity having a configuration to selectively receive said locking support member while preserving the integrity of said connector body after attachment of said angulate contact elements to said second external article, said locking support member having a plurality of parallel teeth, said teeth spaced apart to define a plurality of indentations having a spatial arrangement to individually receive an angulate contact element disposed in an array of at least two rows of said contact elements coupled to said front mating surface of said multiple contact connector . . . .

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1. Reinforcement support member

There is no dispute that the term "support member" means that it holds up or serves as a foundation or prop for the connector and/or a portion of the connector. The parties hotly debate, however, the meaning of the modifier "reinforcement." Amphenol argues, and Maxconn disputes, that it indicates that the member must be removable. In particular, Amphenol argues that the prosecution history demonstrates that the term "reinforcement support member" indicates a component that reinforces and supports the contact in such a manner that it can be removed to allow access to the interior of the connector for inspection and/or repair of the contacts without destroying the integrity of the connector so that the connector is reusable.

a. Claim language

The Court agrees with Maxconn that the language of the claim itself does not support Amphenol's position that the word "reinforcement" somehow implies "removable." Indeed, at oral argument, Amphenol concurred that the ordinary meaning of the term "reinforcement" does not require that the member be removable.

b. Specification

At oral argument, the parties took the position that the specification provides no useful guidance on whether the support member must be removable.

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c. Prosecution History

The entire debate over the meaning of this term centers on the prosecution history. Maxconn points out that the examiner had rejected all claims of the '017 patent as being anticipated by a patent issued to Evans, which describes a connector body with contact receiving cavities. In Evans, the contacts are not independent of the supporting member; rather, the supporting apparatus and the contacts are molded into one piece. Amphenol argues that Maxconn gave a special meaning to "reinforcement" in the course of prosecution in order to emphasize that the member was removable to prevent damage to the contacts.

i. The Original Application

The original application contained three independent claims: Claims 1, 7, and 14. Application Claim 1 was ultimately cancelled. Application Claim 7 ultimately became Claim 1 and Application Claim 14 ultimately became Claim 6 of the Maxconn '017 patent. Accordingly, the Court will focus its discussion on the prosecution history of Application Claims 7 and 14.

Neither of these claims initially included the word "reinforcement." Application Claim 7 claimed "a locking support member having a mating means for selectively engaging said connector body at said open-ended rear surface . . . ." Application dated April 24, 1987, at 9. Application Claim 14 claimed "[a] support device for portions of angulate contact elements within an interior of a multiple contact connector having a front mating surface and an open-ended

rear surface, comprising, a locking support member slidably fit within an open-ended rear surface of a multiple contact connector . . . ." Application dated April 24, 1987, at 11. Initially, the applicant explained that the "locking support member" "permits repair of individual contact elements" in that it "may be removed from the connector," Application dated April 24, 1987, p. 7, and that "[the member] may be detached from the connector to facilitate connector repair." Application dated April 24, 1987, p. 3.

ii. Rejection of Original Claims

The patent examiner found Application Claim 7 unpatentable as anticipated by Evans in view of Reuss or Silbernagel. The examiner also found Application Claim 14 to be anticipated by Evans.

iii. Applicant's First Amendment

The applicant thereafter filed a Substitute Amendment,[3] amending the original claim for a "locking support member" with "locking reinforcement support member." Substitute Amendment mailed December 30, 1987 (emphasis added). The Substitute Amendment pointed out the differences between the present invention and the Evans patent. Among other things, the applicant argued that Application Claim 14 was distinguishable from Evans in that the "contacts are independent of the supporting member and remain so when the supporting member is removed, such as for visual

3. On December 1, 1987, the applicant filed the first amendment, but the Examiner refused to enter it for failure to comply with a rule concerning renumbering of claims.

inspection of the interior of the connector." Substitute Amendment mailed December 30, 1987, p. 6.

As to Application Claim 7, the applicant distinguished the prior art by saying that "the locking support member is removable to allow access to the interior of the connector for inspection and/or repair." Substitute Amendment mailed December 30, 1987, p. 9. He further explained that the removability element was nonobvious: "If the support wafer assembly was removed from the Evans connector, the wire array would be eliminated. . . . Therefore, it teaches away from a removable support connector and would not be obvious to do such." Substitute Amendment mailed December 30, 1987, p. 9. "Applicant is claiming a connector with a support member . . . [which] when removed does not destroy the integrity of the connector." Substitute Amendment mailed December 30, 1987, p. 9.

Discussing the applicable level of skill in the art, the applicant stated that "the present invention is a connector with a support member that when inserted or removed does not destroy the integrity of the connector . . . . The prior art does not anticipate, teach or suggest the present invention of a removable locking support member in an electrical connector." Substitute Amendment mailed December 30, 1987, p. 10.

iv. Rejection of First Amendment

On July 21, 1988, the examiner rejected the claims, explaining that Application Claim 7 was anticipated by McHugh and that Application Claim 14 was anticipated by Silbernagel.

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v. Second Amendment

The applicant then filed an Amendment After Final Rejection. As to Application Claim 7, the applicant amended the claim to incorporate features the examiner had deemed to be patentable (and unrelated to removability). Amendment mailed September 13, 1988, pp. 5-6. As to Application Claim 14, the applicant stated that the invention is an improvement over Silbernagel because the reinforcement support member "is removable to allow access to the interior of the connector for inspection and/or repair." Amendment mailed September 13, 1988, p. 6.

This review of the patent prosecution reveals that the applicant repeatedly argued to the examiner that the point of novelty of the '017 patent was that, unlike previous incarnations of connectors featuring contact wires inextricably encased in supporting material, this new type of support device could be removed from the connector body so as to leave the connector wires intact and to facilitate inspection or repair of the wires.

Maxconn seeks to avoid the effects of the prosecution history by arguing that the statements concerning removability related only to the cancelled Application Claim 1. This argument has no merit. As demonstrated above, the applicant made many representations concerning removability directed to all application claims in general and to claims that became patent Claims 1 and 6. Patent claims may not be interpreted one way in order to obtain their allowance and a different way against accused infringers. See Southwall Technologies, 54 F.3d at 1576.

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d. Extrinsic evidence

Reliance on expert testimony is unnecessary since the meaning of the disputed terms can be ascertained from a reading of the prosecution history.

e. Construction

The "reinforcement support member" is a member that can be removed from the connector body without destroying the integrity of the connector in general or the contact wires in particular so as to facilitate inspection or repair of the contacts.

2. "Selectively"

Maxconn argues that "selectively" refers to the fact that specific grooves of the support member line up with specific wires of the connector. Amphenol argues that "selectively engaging" refers to the manner in which the support member goes into the plug, such that the member can be removed to access the interior of the connector.

a. Claim language

As to the meaning of this disputed term, a close reading of the claim language itself leaves little doubt as to what the applicant meant by "selectively." Claim 1 calls for

> a locking reinforcement support member having a mating means for selectively engaging said connector body at said open-end body cavity . . . .

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Claim 6 calls for

> a locking reinforcement support member slidably fit within said open end of said body cavity defined in said multiple contact connector, said open end of the body cavity having a configuration to selectively receive said locking support member while preserving the integrity of said connector body after attachment of said angulate contact elements to said second external article . . . .

Under Claim 1, the reinforcement support member has a mating means for "selectively engaging" the connector body. Under Claim 6, the body cavity is configured to "selectively receive" the reinforcement support member while preserving the integrity of the connector body. Claim 1 itself defines the element "connector body" as "having a body interior and having a front mating surface and an open-end body cavity." Maxconn '017 patent, col. 5, ll 1-13. The claim does not define "connector body" as including the contact elements, a separate element of the Claim. Maxconn '017 patent, col. 5, ll. 4-13.

Regarding Claim 6, it is the open end of the "body cavity" which selectively receives the reinforcement support member. Claim 6 describes the "body cavity" as just one part of the multiple contact connector: the "contact elements" are described as lying within the interior of the connector, Maxconn '017 patent, col. 6:7-9, while the connector itself is described as having various parts, including "a front mating surface, opposed lateral surfaces, a cover surface, a base

surface and an open-end body cavity" Maxconn '017 patent, col. 6:9-11. The plain language of the itself indicates that the term "body cavity" does not include the contact elements.

The term "selectively" is used only in reference to the connector body or body cavity. It is not used in reference to the contact elements. Accordingly, Maxconn's interpretation involving the mechanism by which the support member mates with particular contact elements cannot be correct.[4] There is no need to consult the specification, prosecution history, or extrinsic evidence for further enlightenment, except to say that Amphenol's interpretation is entirely consistent with the arguments made by the applicant in the course of the prosecution of the patent.

b. Construction

The term "selectively" serves to emphasize that, as the Court concluded in part (B)(1)(e), above, the support member can be removed from the connector body so as to allow access to the interior of the connector, facilitating inspection or repair of the contacts without destroying the integrity of the connector in general or the contact elements in particular.

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4. In addition, later portions of both Claims 1 and 6 contain extensive descriptions of how the teeth of the member interlock with the wires of the connector, further supporting the Court's conclusion that the term "selectively" does not operate to define how the teeth meet with the wires. The extensive descriptions would render the term "selectively" superfluous.

Appendix D

IT IS SO ORDERED.

DATED: 11/20/98

SPENCER WILLIAMS
United States District Judge

APPENDIX E — THE '317 PATENT

[Omitted here but submitted separately as Lodging]